87 No. 1057

Supreme Court, U.S.
FILED
DEC 23 1987
JOSEPH F. SPANIOL, JR.
CLERK

In The

Supreme Court of the United States

October Term, 1987

COOPER INDUSTRIES, INC.,

Petitioner,

v.

JUNO LIGHTING, INC.,

Respondent.

PETITION FOR CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

ROLF O. STADHEIM
HAIGHT & HOFELDT
55 East Monroe Street
Suite 3614
Chicago, Illinois 60603
(312) 263-2353

Counsel for Petitioner
COOPER INDUSTRIES, INC.

Of Counsel:

JOSEPH A. GREAR
DOUGLAS J. BORNEMANN
HAIGHT & HOFELDT
55 East Monroe Street
Suite 3614
Chicago, Illinois 60603
(312) 263-2353

ALAN THIELE
First City Tower, Suite 4000
Houston, Texas 77210

December 23, 1987

---

60 pp

QUESTIONS PRESENTED

I.

After a jury returns a verdict in a civil case, the court, on a motion for judgment notwithstanding the verdict, can overturn the verdict only if it is not supported by sufficient evidence.

In deciding a motion for judgment notwithstanding the verdict, which evidence does the court consider in determining whether there is sufficient evidence? Does it

A. consider "all of the evidence," as held by the Federal Circuit below and by the 5th, 11th and D.C. Circuits;

B. consider only the evidence that supports the verdict, as held by this Court and the 8th and Federal Circuits; or

C. apply some intermediate approach, as variously held by the 1st, 2nd, 3rd and 4th Circuits?

II.

Is the Seventh Amendment's proscription, that no fact tried to a jury shall be "reexamined in any Court," violated by a court relying on "all of the evidence," as contrasted to just the evidence supporting the verdict, in granting a judgment notwithstanding the verdict?

PARTIES TO THE PROCEEDINGS BELOW

1. Plaintiff-Appellant (Petitioner), Cooper Industries, Inc.;

2. Defendant-Cross Appellant (Respondent) Juno Lighting, Inc.; and

3. Defendant, Robert Fremont.*

*Robert Fremont, President of Juno Lighting, Inc., was dismissed from the case.

STATEMENT PURSUANT TO RULE 28.1

Cooper Industries, Inc. is a publicly held corporation with the following divisions:

Ajax
Corry, Pennsylvania

Apex
Dayton, Ohio

Arrow Hart
Hartford, Connecticut

Belden Electrical Wire Products
Geneva, Illinois

Belden Electronic Wire and Cable
Richmond, Indiana

Bussmann
Ellisville, Missouri

Campbell Chain
York, Pennsylvania

Cooper Air Tools
Lexington, South Carolina

Cooper-Bessemer Reciprocating
Grove City, Pennsylvania

Cooper-Bessemer Rotating
Mount Vernon, Ohio

Cooper Hand Tools
Raleigh, North Carolina

Crouse-Hinds Distribution Equipment
Earlysville, Virginia

Crouse-Hinds Electrical
Construction Materials
Syracuse, New York

Crouse-Hinds Lighting
Products
Vicksburg, Mississippi

Demco
Oklahoma City, Oklahoma

Energy Services Group
Mount Vernon, Ohio

Funk
Coffeyville, Kansas

Gardner-Denver
Compressors
Quincy, Illinois

Gardner-Denver Mining
& Construction
Roanoke, Virginia

Halo Lighting
Elk Grove Village, Illinois

Kirsh
Sturgis, Michigan

Martin-Decker
Cedar Park, Texas

McGraw-Edison Power
Systems
Corapolis, Pennsylvania

Petroleum Equipment
Quincy, Illinois

Superior
Springfield, Ohio

Wagner
Parsippany, New Jersey

TABLE OF CONTENTS

Page(s)

QUESTIONS PRESENTED i

PARTIES TO THE PROCEEDINGS BELOW. ii

STATEMENT PURSUANT TO RULE 28.1 ii

TABLE OF CONTENTS iv

TABLE OF AUTHORITIES. vi

OPINIONS BELOW. 1

JURISDICTION. 2

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED. 2

STATEMENT OF THE CASE 3

REASONS FOR GRANTING THE WRIT 6

I. SUMMARY OF REASONS. 6

II. THE CIRCUITS ARE IN DIRECT CONFLICT. 8

A. "All of the Evidence" - Federal, 5th, 11th and D.C. Circuits 8

B. Only the Supporting Evidence - Supreme Court, 8th and Federal Circuits 9

C. Middle Grounds - 1st, 2nd, 3rd and 4th Circuits 12

III. RESOLUTION OF THE CONFLICT IS VITAL. 13

Page

IV. THE SEVENTH AMENDMENT IS VIOLATED WHEN A VERDICT IS OVERTURNED BASED ON "ALL OF THE EVIDENCE" 15

CONCLUSION. 19

APPENDIX

TABLE OF AUTHORITIES

Cases: *Page(s)*

Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 91 L.Ed.2d 202 (1986) 6, 17, 18

Boeing Company v. Shipman, 411 F.2d 365 (5th Cir. 1969) 9, 14

Carter v. Duncan-Huggans, Ltd. 727 F.2d 1225 (D.C. Cir. 1984) 9

County of Los Angeles v. Kling, 474 U.S. 936 (1985). 11

Dace v. ACF Industries, Inc., 722 F.2d 374 (8th Cir. 1984) 10, 14, 16

Dimick v. Schiedt, 293 U.S. 474 (1935) 15

Fireman's Fund Ins. Co. v. Videfreeze Corp., 540 F.2d 1171 (3rd Cir. 1976) 12

Galloway v. United States, 319 U.S. 372 (1942) 16

Grogan v. General Maintenance Service Co., 763 F.2d 444 (D.C. Cir. 1985) 9

Jamesbury Corp. v. Litton Indus. Products, Inc., 756 F.2d 1556 (Fed. Cir. 1985) 8

Koch Security v. Secretary of the Department of Health, Education & Welfare, 590 F.2d 260 (8th Cir. 1978) 10

Layne v. Vinzant, 657 F.2d 468 (1st Cir. 1981) 8, 12, 14

Novack Investment Co. v. Setser, 454 U.S. 1064 (1981) 19

Page(s)

Orthokinetics, Inc. v. Safety Travel Chairs, Inc. 806 F.2d 1565 (Fed. Cir. 1986) 6, 9, 10, 14, 16

Parklane Hosiery Co. v. Shore, 439 U.S. 322 (1979) 18

Parts and Electric Motors, Inc. v. Sterling Electric, Inc., 826 F.2d 712 (7th Cir. 1987) 11

Quaker City Gear Works, Inc. v. Skil Corp., 747 F.2d 1446 (Fed. Cir. 1984) 8

Reynolds v. CLP Corporation, 812 F.2d 671 (11th Cir. 1987) 9

St. Paul Fire & Marine Ins. Co. v. Vaughn, 779 F.2d 1003 (4th Cir. 1985) 13

Schwimmer v. Sony Corp. of America, 459 U.S. 1007 (1982) 7, 13

Selle v. Gibb, 741 F.2d 896 (7th Cir. 1984) 11

Simblest v. Maynard, 427 F.2d 1 (2nd Cir. 1970) 12

Venture Technology, Inc. v. National Fuel Gas Distribution Corp., 459 U.S. 1007 (1982) 7, 13

Webb v. Illinois Central Railroad Co., 352 U.S. 512 (1956) 10

Wilkerson v. McCarthy, 336 U.S. 53 (1949) 6, 7, 9, 10, 14, 16

Williams v. City of Valdosta, 689 F.2d 964 (11th Cir. 1982) 9

Page(s)

U. S. Constitution

United States Constitution, Amendment VII 2, 15

Rules

Federal Rules of Civil Procedure 50(b), 28 U.S.C. 2

Statutes

Title 28 U.S.C. Sec. 1338 (a) 4

Title 28 U.S.C. 1254 (1) 2

Other

3 Writings of Thomas Jefferson (Washington ed.) 43 6

Detailed Statistical Tables Annual Report of the Director of the Administrative Office of the U.S. Courts, (June 30, 1987) 7, 13

9 Wright & Miller, Federal Practice and Procedure Civil Sec. 2529, p. 572 (1971) 13, 14

No.

In The
Supreme Court of the United States
October Term, 1987

COOPER INDUSTRIES, INC.,

Petitioner,

v.

JUNO LIGHTING, INC.,

Respondent.

PETITION FOR CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

The petitioner Cooper Industries, Inc. respectfully prays that a writ of certiorari issue to review the judgment and opinion of the United States Court of Appeals for the Federal Circuit, entered in the above-entitled case on July 27, 1987.

OPINIONS BELOW

The opinion of the Court of Appeals for the Federal Circuit has not been reported. It is reprinted in the appendix hereto, p. A25, *infra*.

The *Amended Summary Opinion* of the United States District Court for the Northern District of Illinois dated January 28, 1987, has been reported at 2 USPQ2d 1779 (1987), and is reprinted in the appendix hereto, p. A14, *infra*. The oral opinion of December 3, 1986 is reprinted in the appendix hereto, p. A1, *infra*.

JURISDICTION

The decree of the Federal Circuit was entered on July 27, 1987. Petitioner's petition for rehearing was denied on August 27, 1987 and its suggestion for rehearing in banc was declined on September 23, 1987. This Court, on November 10, 1987, extended the time to file this petition until December 23, 1987.

The jurisdiction of this Court is invoked under 28 U.S.C. 1254 (1).

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

United States Constitution

AMENDMENT VII – CIVIL TRIALS

> In Suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved, and no fact tried by a jury, shall be otherwise reexamined in any Court of the United States, than according to the rules of the common law.

Federal Rules of Civil Procedure

RULE 50(b)

> Whenever a motion for a directed verdict made at the close of all the evidence is denied or for any reason is not granted, the court is deemed to have submitted the action to the jury subject to a later determination of the legal questions raised by the motion. Not later than 10 days after entry of judgment, a party who has moved for a directed verdict may move to have the verdict and any judgment entered thereon set aside and to have judgment entered in accordance with the party's motion for a directed verdict; or if a verdict was not returned such party, within 10 days after the jury has been discharged, may move for judgment in accordance with the party's motion for a directed verdict. A motion for a new trial

> may be joined with this motion, or a new trial may be prayed for in the alternative. If a verdict was returned the court may allow the judgment to stand or may reopen the judgment and either order a new trial or direct the entry of judgment as if the requested verdict had been directed. If no verdict was returned the court may direct the entry of judgment as if the requested verdict had been directed or may order a new trial.

STATEMENT OF THE CASE

In the mid-1970's, a spate of unexplained attic fires in homes throughout the country spurred the National Fire Prevention Association, the Consumer Products Safety Commission and the Department of Energy to investigate (0146-148; 0922).[1] The culprit was the increasingly popular recessed lighting fixture (1182). While aesthetically pleasing and practical, the fixtures created a fire hazard: if cellulosic attic insulation is improperly installed and surrounds the fixture, the heat generated by the lamp cannot dissipate because of the insulation but will build up outside the fixture and ignite the inflammable cellulosic insulation (0901).[2]

The National Fire Prevention Association in conjunction with Underwriters Laboratories took action, directing that all such recessed fixtures must have "thermal protection" (0148; 0901). A two year hiatus was provided for research and development, after which it became mandatory that recessed fixtures meet specifically designed Underwriters Laboratories fire safety tests requiring that

---

[1] The page references are to the Joint Appendix filed in the court of appeals.

[2] Cellulosic insulation is shredded newspaper treated with a fire retardant. When subjected to high temperatures the retardant evaporates, leaving a highly inflammable material. Cellulosic insulation is commonly used in homes throughout the United States. (0145-146)

the lamp disconnect whenever the temperature outside the fixture reaches 90 degrees centigrade (0148).

Petitioner's research laboratories at its Halo Lighting Division discovered a practical and reliable solution to the problem whereby the lamp disconnects when a predetermined temperature is reached outside of the fixture (0148-165). The invention was awarded a United States patent (No. 4,450,512) (0897).[3] After successfully passing the U.L. safety tests, Halo began manufacturing and selling its new thermally protected fixture (0165-166). Shortly thereafter, Respondent, Juno Lighting, Inc., copied Petitioner's fixture (A10, *infra;* 0289-301), and this patent infringement case ensued (28 U.S.C. Sec. 1338 (a)).

The jury found that Juno had infringed; that the infringement was willful; and rejected Juno's various defenses attacking the validity and enforceability of the patent (0057-58).

The district court granted judgment notwithstanding the verdict, finding that the Juno fixture "couldn't have been responding to the outside temperature" (A6, *infra*), and neither could the Halo, or any fixture with the thermal protector inside the fixture. Accordingly, the court ruled that the patent was not infringed and was not valid (A11, *infra*). On appeal, the Court of Appeals for the Federal Circuit affirmed (A25-26, *infra*).

The only issue was whether there was sufficient evidence to support that portion of the jury's verdict finding

---

[3] The invention, as variously claimed in the patent, calls for a thermal protector located on the inside of the sidewall of the lighting fixture at a predetermined height, preferably 3 to 3 1/2 inches from the bottom, in alignment with an aperture in the sidewall and mounted in a receptacle, preferably reflective, which urges the thermal protector against the sidewall, such that the thermal protector responds to the temperature in the area outside the fixture reaching a predetermined temperature to disconnect the lamp (0903-04).

that the lamp in the Juno fixture disconnected (as recited in the patent, Claim 9)

> . . . in response to the temperature in an area surrounding the outside of said lighting fixture reaching a predetermined temperature.

Petitioner's evidence established that the Juno fixture (0950) – just like the Halo fixture (0951) from which it was copied (A10 *infra;* 0289-301) – passed the Underwriters Laboratories tests that required that the lamp disconnect in response to a predetermined outside temperature (0918):

> Underwriters Laboratories . . . conducts tests as follows: . . . The thermal device must disconnect the fixture when any point in contact with insulation [outside the fixture] reached 90 degrees C.

Moreover, the inventor testified that the Juno fixture infringed, explaining that when the cellulosic insulation is carelessly injected and allowed to surround the fixture, the heat that normally dissipates into the airspace is blocked and builds up (0164-171; 0245; 0271). Thus, when a "predetermined temperature" outside the fixture is reached, the thermal protector inside the fixture, which is set to another predetermined temperature, responds and disengages the lamp (0903-904).

The courts below ignored this evidence supporting the verdict, focused on Juno's contrary evidence, and concluded that there was no evidence in support of the verdict (A27, *infra*)

The legal issue squarely emerged when the court of appeals held (A26, *infra*):

> Cooper mistakenly asserts that in deciding whether there was substantial evidence, "the focus is on the evidence that supports the verdict, not on the evidence that might support a contrary conclusion." Rather. . . " '[s]ubstantial evidence' is such relevant evidence from the record *taken as a whole* as might be accepted by a reasonable mind as adequate to support the finding under review."

"Applying this standard," the court affirmed the overturning of the jury's verdict (A26, *infra*).

Petitioner moved for rehearing and suggested an in banc rehearing, urging the court to resolve the conflict between the decision here and both its own prior holding in *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565 (Fed. Cir. 1986), and that of the Supreme Court in *Wilkerson v. McCarthy*, 336 U.S. 53, 57 (1949):

> It is the established rule that in passing upon whether there is sufficient evidence to submit an issue to the jury we need look only to the evidence and reasonable inferences which tend to support the case of a litigant against whom a peremptory instruction has been given.[4]

Both the petition and the suggestion were declined.

REASONS FOR GRANTING THE WRIT

> I consider trial by jury as the only anchor ever yet imagined by man, by which a government can be held to the principles of its constitution.
>
> 3 Writings of Thomas Jefferson (Washington ed.) 43

I. SUMMARY OF REASONS

The happenstance of where venue is lodged in a federal civil case may govern whether a jury's verdict survives. In ruling on motions for judgment notwithstanding the verdict, the several circuits follow disparate rules as to which evidence is considered in determining whether the verdict was supported by sufficient evidence. Some circuits consider "all of the evidence." Others look only to the evidence in support of the verdict. And still others follow

---

[4] The standard on a motion for judgment n.o.v. is the same as that for a directed verdict (Fed.R.Civ.P. 50), and "mirrors" that for summary judgment (*Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, ___, 91 L.Ed.2d 202, 213-14, 106 S.Ct. 2505, 2511-12 (1986).

a middle ground and look only to supporting or uncontradicted evidence.

While this Court has spoken — "It is the established rule that . . . we need look only to the evidence and the reasonable inferences which tend to support the [verdict] . . . " *Wilkerson v. McCarthy*, 336 U.S. 53, 57 (1949) – neither the court below, nor most of the other circuits have listened.

The conflict is not new. Five years ago, Justice White unsuccessfully urged this Court to grant certiorari on the very question here presented, observing: "Thus, the Federal Courts of Appeals follow three different approaches to determining whether evidence is sufficient to create a jury issue." *Schwimmer v. Sony Corp. of America*, and *Venture Technology, Inc. v. National Fuel Gas Distribution Corp.*, 459 U.S. 1007, 1009 (1982).

The conflict "is of far more than academic interest." *Id.* at 1009. Its resolution "will often be influential, if not dispositive, of a motion for judgment n.o.v." *Id.* Last year, more than half the civil cases tried in the federal courts were jury cases – 6,299 cases per year or over 120 a week.[5]

The importance of resolving the conflict is magnified by the Seventh Amendment's guarantee of a trial by jury and the further guarantee that

> . . . no fact tried by a jury, shall be otherwise reexamined in any Court of the United States, than according to the rules of the common law.

A court that relies on "all of the evidence," rather than "only . . . the evidence and the reasonable inferences which tend to support the [verdict]" (*Wilkerson v. McCarthy*, 336 U.S. 53, 57 (1949)), runs afoul of this Constitutional proscription against "reexamining" the facts.

---

[5] *Detailed Statistical Tables Annual Report of the Director of the Administrative Office of the U.S. Courts*, (June 30, 1987) Appendix 1, pp. 205.

II. THE CIRCUITS ARE IN DIRECT CONFLICT

On a motion for judgment notwithstanding the verdict, the issue is whether there is sufficient evidence to support the verdict. The question raised by this petition is: What evidence may the court rely on, i.e., what is the court's "field of vision",[6] in deciding whether a jury verdict is supported by sufficient evidence: Does it consider "all of the evidence"; only the evidence supporting the verdict; or only the supporting evidence and the uncontradicted evidence.[7] Each approach has its supporters among the several circuit courts of appeals.

A. "All of the Evidence" - Federal, 5th, 11th and D.C. Circuits

The Court of Appeals for the Federal Circuit below and the Fifth, Eleventh and D.C. Circuits have held that "all of the evidence" should be considered in deciding a motion for judgment n.o.v. A sampling of those decisions follows.

Federal Circuit

The holding below, that the court considers the evidence *"taken as a whole,"* rather than focusing only on the evidence supporting the verdict (p. 5, *supra*; p. A26, *infra*), follows upon two earlier Federal Circuit decisions:

> Under Quaker City's [the jury winner's] view, we would look *only* to evidence in its favor to determine whether "substantial evidence" supports . . . [the verdict]. The law is clearly to the contrary.

Quaker City Gear Works, Inc. v. Skil Corp., 747 F.2d 1446, 1454 (Fed. Cir. 1984); (*Jamesbury Corp. v. Litton Indus. Products, Inc.*, 756 F.2d 1556, 1563 (Fed. Cir. 1985).

---

[6] *Layne v. Vinzant*, 657 F.2d 468, 472 (1st Cir. 1981)

[7] Thus, the question is not, *how much evidence* constitutes sufficient evidence to support a verdict, but *which evidence* is considered in deciding whether there is sufficient evidence.

Contra, Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565 (Fed. Cir. 1986)).

5th Circuit

The issue was examined in banc by the Fifth Circuit in *Boeing Company v. Shipman*, 411 F.2d 365, 374 (5th Cir. 1969):

> On motions for directed verdict and for judgment notwithstanding the verdict the Court should consider all of the evidence – not just that evidence which supports the non-mover's case. . . .

11th Circuit

The same standard was adopted by the Eleventh Circuit in *Williams v. City of Valdosta*, 689 F.2d 964, 970 (11 Cir. 1982) and *Reynolds v. CLP Corporation*, 812 F.2d 671, 674 (11th Cir. 1987). Quoting from *Boeing Company v. Shipman, supra* at 374, the court held in *Williams*: ". . . the Court should consider all of the evidence – not just that evidence which supports the non-mover's case. . . ."

D.C. Circuit

In *Carter v. Duncan-Huggins, Ltd.*, 727 F.2d 1225, 1227 (D.C. Cir. 1984), the D.C. Circuit stated: "Necessarily, the reviewing court must consider all the evidence offered." See also, *Grogan v. General Maintenance Service Co.*, 763 F.2d 444, 447 (D.C. Cir. 1985)

B. Only the Supporting Evidence - Supreme Court, 8th and Federal Circuits

Supreme Court cases, as well as decisions in two circuits, focus only on the evidence that supports the verdict, i.e., the evidence upon which the jury presumptively relied.

The Supreme Court

This Court's pronouncement in *Wilkerson v. McCarthy, supra* while not following upon any discussion of the issue, is emphatic (336 U.S. at 57):

> It is the established rule that in passing upon

> whether there is sufficient evidence to submit an issue to the jury we need look only to the evidence and reasonable inferences which tend to support the case of a litigant against whom a peremptory instruction has been given.

It was repeated in *Webb v. Illinois Central Railroad Co.*, 352 U.S. 512, 513-14 (1956).

8th Circuit

The Eighth Circuit confronted the issue head on in *Dace v. ACF Industries, Inc.*, 722 F.2d 374, 376 (8th Cir. 1984):

> The question arises whether the court is permitted to consider evidence that is unfavorable to the party opposing the motion....We have recently stated flatly that on a motion for directed verdict "[a]ny evidence produced by the prevailing party [the movant] must be disregarded." *Koch Security v. Secretary of the Department of Health, Education & Welfare*, 590 F.2d 260, 261 (8th Cir. 1978) (citations omitted).

Wilkerson was quoted as reciting the same rule.

Federal Circuit

The Federal Circuit has gone both ways. While subscribing to the "all of the evidence" approach below and in two earlier decisions, the court vigorously endorsed the "only the supporting evidence" approach in the intervening case of *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1572, 1573 (Fed. Cir. 1986):

> The district court focused on evidence in support of Safety's contentions, rather than on evidence in support of the jury's findings. That approach constitutes reversible legal error. . . .
>
> * * *

> Whether there may or may not have been evidence that might have supported a contrary conclusion is simply irrelevant.[8]

As noted above, Petitioner's motions for rehearing and in banc rehearing were both declined. The court saw nothing inharmonious between its decisions; found that the opinion below ". . .does not add significantly to the body of law and is not of widespread legal interest" and designated it not for publication and "not citable as precedent" (A25, *infra*). Petitioner's motion for publication was also denied (A29).[9]

---

[8] The Seventh Circuit, although not explicitly addressing the issue, seems also to have simultaneously adopted both ends of the spectrum. On the one hand, it suggests looking only to the supporting evidence (" 'In view of the Seventh Amendment's prohibition . . . a jury verdict can only be set aside if . . . there is a total failure of evidence to prove the plaintiff's case.' " *Parts and Electric Motors, Inc. v. Sterling Electric, Inc.*, 826 F.2d 712, 720 (7th Cir. 1987)). On the other hand, it suggests the "all of the evidence" approach ("All the evidence, taken as a whole, must be viewed in the light most favorable to the nonmoving party." *Selle v. Gibb*, 741 F.2d 896, 900 (7th Cir. 1984)).

[9] While the practice of issuing unpublished decisions certainly can ease the workload of today's overburdened courts of appeals, there is the attendant risk of misdesignating an opinion that does affect the body of law and that should be open to comment, criticism and further review by the bench, bar and public.

Here, the ". . . decision not to publish the opinion or permit it to be cited – like the decision to promulgate a rule spawning a body of secret law – was plainly wrong." *County of Los Angeles v. Kling*, 474 U.S. 936, 938 (1985) (Stevens, J., dissenting)

The point is dramatically brought home by the recently filed petition for certiorari in *Fonar Corp. v. Johnson & Johnson*, 87-822. That petition raises the same issues as presented here, but there, the petitioner was unaware of the "secret" law decided by the court below.

C. Middle Grounds - 1st, 2nd, 3rd and 4th Circuits

Finally, four circuits have taken middle grounds, rejecting the "all the evidence" approach yet modifying the "only the supporting evidence" approach. The rule, as variously laid down by these circuits, is that, in addition to the supporting evidence, "uncontradicted" evidence, or "uncontradicted and unimpeached" evidence is also weighed.

1st Circuit

In *Layne v. Vinzant*, 657 F.2d 468, 472 (1st Cir. 1981), the First Circuit stated the rule:

> The first [principle] is that while, on a defendant's motion, it is axiomatic that the evidence is to be viewed in the light most favorable to the plaintiff, the "field of vision" encompasses, to a degree, uncontradicted evidence introduced by the defense.

2nd Circuit

A tighter rule is advanced by the Second Circuit in *Simblest v. Maynard*, 427 F.2d 1, 5 (2nd Cir. 1970): The court should "... [consider] ... only the evidence favorable to plaintiff and the uncontradicted, and unimpeached evidence unfavorable to him..."

3rd Circuit

The Third Circuit, *Fireman's Fund Insurance Co. v. Videfreeze Corp.*, 540 F.2d 1171, 1180 (3rd Cir. 1976), considers the supporting evidence and "... take[s] into account uncontradicted evidence tending to undermine the defendant's [the jury winner] prima facia case...."

4th Circuit

The Fourth Circuit looks at the supporting evidence and unfavorable evidence that the jury is required to believe, *St. Paul Fire & Marine Ins. Co. v. Vaughn*, 779 F.2d 1003, 1008 (4th Cir. 1985):

> . . . [W]e consider "all of the evidence favorable to the position of the party opposing the motion as well as any unfavorable evidence that the jury is required to believe." 9 C. Wright and A. Miller, Federal Practice and Procedure § 2529 (1971). Specifically, we must take into account the "uncontradicted and unimpeached" evidence in support of the moving party. *Id.*[10]

III. RESOLUTION OF THE CONFLICT IS VITAL

Last year 6,299 juries delivered verdicts in the federal courts of the United States (footnote 5, *supra*). The fate of these verdicts was contingent upon the geographical location where the jury happened to sit. As Justice White observed, in urging that this conflict be addressed and resolved (*Schwimmer v. Sony Corp. of America*, and *Venture Technology, Inc. v. National Fuel Gas Distribution Corp.*, 459 U.S. 1007, 1009 (1982) dissent from denial of certiorari):

> Thus, the Federal Courts of Appeals follow three different approaches to determining whether evidence is sufficient to create a jury issue. . . . Because the scope of review will often be influential, if not dispositive, of a motion for judgment n.o.v., this disagreement among the Federal Courts of Appeals is of far more than academic interest.

That was five years ago; in the interim, the discord among the several circuits has not decreased – it has increased. No circuit has reconsidered its position, and

---

[10] As for the remaining circuits, the Seventh Circuit, as noted *supra*, fn. 8, appears to support both poles. The Sixth, Ninth and Tenth Circuits have not addressed the issue.

the two newly created circuits have merely added to the discord. As seen, the Eleventh Circuit, mirroring the Fifth Circuit, adopted the "all of the evidence" approach, and the Federal Circuit, mirroring all of the circuits, simultaneously embraced both poles of the issue; invoking the "all of the evidence" approach in three cases, yet ardently applying the "only the supporting evidence" rule in another.

In the meanwhile, this Court's pronouncement in *Wilkerson* has all but slipped from notice. In recent years, only the Eighth Circuit has relied on it, *Dace v. ACF Industries, Inc., supra.* Other courts "have refused to believe that the Supreme Court meant what it said" and dismiss *Wilkerson* "as limited to FELA cases." 9 Wright & Miller, Federal Practice and Procedure Civil Sec. 2529, p. 572 (1971); *Boeing Company v. Shipman*, 411 F.2d 365, 375, fn. 16 (in banc) (5th Cir. 1969).[11] Still other courts, like the court below, simply ignore it (*e.g., Layne v. Vinzant*, 657 F.2d 468 (1st Cir. 1981); *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565 (Fed. Cir. 1986)).

The conflict shows no sign of resolution without the intervention of this Court. After percolating in the lower courts for decades, positions have solidified. The result is the daily application of incompatible standards that, as Justice White observed "will often be influential, if not dispositive" of jury cases throughout the nation.

The need for resolution is underscored by the just filed petition for certiorari in *Fonar Corp. v. Johnson & Johnson*, 87-822, raising the conflict.

But there is more than conflict. There is a grave Constitutional issue.

---

[11] The contrary view was expressed in the forceful dissent in *Boeing v. Shipman*, Id. at 386: "... Indeed, it seems an unwarranted affront to suggest that the Supreme Court, by mere fiat, has invented for FELA cases a kind of jury trial found neither in the Constitution nor in the [FELA] Act."

IV. THE SEVENTH AMENDMENT IS VIOLATED WHEN A VERDICT IS OVERTURNED BASED ON "ALL OF THE EVIDENCE"

> Maintenance of the jury as a fact-finding body is of such importance and occupies so firm a place in our history and jurisprudence that any seeming curtailment of the right to a jury trial should be scrutinized with the utmost care.
>
> *Dimick v. Schiedt*, 293 U.S. 474, 486 (1935).

No one would question that it is the exclusive province of the jury to find the facts and that once found, no court shall "reexamine" them.

> . . . [T]he right of trial by jury, shall be preserved, and no fact tried by a jury shall be otherwise reexamined in any Court of the United States, than according to the rules of the common law. U.S. Const. Amend. VII.

Yet, the day to day adherence of that injunction is not secure.

In overturning a jury verdict by relying on "all of the evidence," as contrasted to only the supporting evidence, a court must "reexamine" the facts and encroach upon the province of the jury.

The logic is compelling. If a verdict is overturned after consideration of "all of the evidence," there are but two possibilities: either the court relied solely on the evidence in support of the verdict, or it did not. If the former, then the review of "all of the evidence" was a superfluous act – in the end, the court based its decision only on the supporting evidence, not "all of the evidence." If the latter, then the court relied on evidence that did not support the verdict, and since the court must presume that the only evidence accepted by the jury is that which supports the verdict, the court must have relied on evidence that was not accepted by the jury. Thus, by relying on "all of the

evidence," the court, of necessity, "reexamines" the facts in violation of the Seventh Amendment.

The point was made by the Federal Circuit in *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1573 (Fed. Cir. 1986):

> . . . [T]he jury had the right to reject *its* [the jury loser's] evidence as insufficient to carry that burden. . . . Because a jury must by definition be permitted to accept some probative evidence and reject other probative evidence, we may not decide whether we would as jurors have found Orthokinetics' evidence . . . "believable in light of the evidence as a whole."
>
> * * *
>
> Whether there may or may not have been evidence that might have supported a contrary conclusion is simply irrelevant.

Similarly, the Eighth Circuit in *Dace v. ACF Industries, Inc.*, 722 F.2d 374, 376 (8th Cir. 1984) reasoned:

> . . . [W]e have said that the court is not to consider questions of credibility when deciding whether to grant a directed verdict. . . . That statement necessarily implies that evidence favorable to the moving party may not be considered, because if it were the court would have to pass on the credibility of that party's witnesses.

Focusing solely on the supporting evidence comports with the common law demurrer, the only procedure known to the common law at the time the Seventh Amendment was adopted by which a case could be withdrawn from the jury and decided by a judge. Under that practice, the court considered only the sufficiency of the non-mover's case as pleaded, ignoring the factual merits of the moving party. *Galloway v. United States*, 319 U.S. 372, 393 (1942).

Thus, considering "all of the evidence," is not only contrary to this Court's teaching in *Wilkerson*, it is unconstitutional. So also is the middle ground approach of relying on "uncontradicted" or "unimpeached" evidence in granting a

judgment n.o.v. Simply because evidence is uncontradicted or unimpeached does not mean that the jury (or anyone else) should accept it; the source of the evidence, be it a witness, document or demonstration, may, for a myriad of reasons, lack credibility in the eyes of the jury – the sole judges of credibility and of the weight of the evidence.[12] "Credibility determinations, the weighing of the evidence, and the drawing of legitimate inferences from the facts are jury functions, not those of a judge, whether he is ruling on a motion for summary judgment or for a directed verdict." (*Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, ___, 91 L. Ed. 2d 202, 216, 106 S.Ct. 2505, 2513 (1986)).

One might ask: if the logic establishing unconstitutionality is so compelling and easy to grasp, why have so many federal courts condoned, indeed mandated, that "all of the evidence" be considered? Two likely explanations emerge. First, the notion of considering all the evidence, not just a selected portion of the evidence, rings loudly of truth and rationality – who would dare argue against it? The answer is, that in passing on a jury's verdict, the strictures of the Seventh Amendment forbid it – the jury is the sole fact finder; it is the *jury* that considers all of the evidence. Second, given that the judge is charged with the duty of overturning verdicts that have insufficient evidentiary support, it might seem, at least at first blush, that the court is similarly charged with overturning verdicts that appear to be clearly unreasonable, especially where the judge has heard or reviewed all the evidence. Yet, what seems a small step, is in fact a giant leap.

Forgotten is that the Framers of the Constitution

---

[12] A distinction should be drawn between evidence that is not assailed and that which is unassailable, e.g., a stipulated fact. While a jury can, quite reasonably, reject the former, it would seem that it would have to accept the latter.

insisted upon the right to a trial by jury for the very reason that often judges and juries see the world from quite different perspectives. What is eminently reasonable to one, may be utter nonsense to the other. Chief Justice Rehnquist put it succinctly (*Parklane Hosiery Co. v. Shore*, 439 U.S. 322, 354, (1979) dissenting opinion):

> It is precisely because the Framers believed that they might receive a different result at the hands of a jury of their peers than at the mercy of the sovereign's judges, that the Seventh Amendment was adopted.

Once the verdict is returned, the facts, which must be presumed to have been found by the jury, are fixed. It is not the office of the judge to step into the jury box and rewrite those findings in light of "all of the evidence."[13]

---

[13] *Cf. Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, ___, 91 L.Ed.2d 202, 226, 106 S.Ct. 2505, 2521 (1986) (Rehnquist, J., dissenting). (After positing an overwhelming testimonial case for defendant) "... [O]ne would hope that a properly charged jury would quickly return a verdict for the defendant. But as long as credibility is exclusively for the jury, it seems the Court's analysis would still require this case to be decided by that body."

CONCLUSION

The conflict is entrenched, the issue is vital. To borrow from *Novack Investment Co. v. Setser*, 454 U.S. 1064, 1065 (1981) (White, J., Brennan, J., and Marshall J., dissenting from denial of cert.):

> . . . [T]he right to a jury trial is fundamental. It is not a tolerable rule of law that one's right to a jury trial depends upon the geographical location of the federal district court within which one files a complaint. This is precisely what is involved in this case.

The writ should issue.

Respectfully Submitted,

ROLF O. STADHEIM
HAIGHT & HOFELDT
55 East Monroe Street
Suite 3614
Chicago, Illinois 60603
(312) 263-2353

Counsel for Petitioner
COOPER INDUSTRIES, INC.

December 23, 1987

APPENDIX

APPENDIX TABLE OF CONTENTS

Page

DISTRICT COURT ORAL OPINION (12/3/86) A1

DISTRICT COURT *AMENDED SUMMARY OPINION* (1/28/87) A14

COURT OF APPEALS OPINION (7/27/87) A25

MOTION FOR PUBLICATION OF DECISION (9/11/87) A29

IN THE UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION

COOPER INDUSTRIES, INC.,
Plaintiff,

v.

JUNO LIGHTING, INC.,
Defendant.

85 C 7243
Chicago, Illinois
December 3, 1986
3:00 p.m.

EXCERPT OF PROCEEDINGS

BEFORE: THE HONORABLE HUBERT L. WILL, S. J. and a Jury.

APPEARANCES:

FOR THE PLAINTIFF: MR. ROLF O. STADHEIM
MR. JOSEPH A. GREAR

FOR THE DEFENDANT: MR. JOHN P. MILNAMOW
MR. EVAN KENT

COURT REPORTER: DOLORES BRENNAN

* * *

THE COURT: Would you pass out the original exhibit books to the jury, please.

I have asked that the original exhibits be given back to you so you can refer to them in connection with what I am about to say.

At the conclusion of all of the evidence on the issues of validity and infringement, and again, at the conclusion of the evidence on damages, the defendants have moved that I set aside your findings with respect to both infringement, wilfull infringement, and validity on the grounds that they are clearly erroneous under the evidence which was presented, in the light of the evidence which was presented in

the case, and under the applicable principles of patent law, which I explained to you in my instructions.

In more than 25 years I have only set aside one jury verdict, but I am going to set aside your jury verdict and I am going to tell you why. I think I owe it to you because I know you tried very hard to understand what was going on, and to apply the law to the facts and the evidence as you found them. I hope you will understand when I finish my explanation why I think you were clearly wrong in the conclusions which you reached.

Let us talk first about infringement.

In order determine infringement, you have to compare the device that is the Juno TC2 with the claims of the patent, and the device has to fall within the claims of that patent.

The first question becomes, what do the claims of the patent say. Patent law is very clear that where a patent application has been filed, and then it has been modified because it was originally rejected, and has been narrowed and limited by the modification, that the patent must be read as so modified, so narrowed and so limited.

Now what happened in this case?

If you will look in your exhibit books to Exhibit 10 which is what is called the File Wrapper - - you will recall that is the Patent Office record - - if you will look at page 12 of the first large document that appears in there after the patent itself, it is the original application. There is a covering letter dated September 7, 1982, and then there is what is called, " . . . arrangement for mounting a thermal protected device in a recessed, mounted lighting fixture".

Do you see that?

Then, page 12, of that starts out at the top of the page, "Claims" and then it was crossed out and it says, "1. Claim".

Do you see that?

Well, on the original claim, if you will read it, in the very first number one paragraph, it says:

"... in a lighting fixture adapted for recessed mounting in a ceiling for the light support surface.." et cetera.

That just describes what you are talking about. you are talking about a recessed lighting fixture.

".. a thermal protective device" - - this is now the fifth line I am reading - - "a thermal protective device connected electrically to said lamp for discontinuing the operation thereof in response to the temperature in an area adjacent said fixture" - - and "the outside of" was not in the original application.

You understand that? The original application said,

"... adjacent said fixture reaching a predetermined temperature, said thermal protective device including temperature sensing means", and so forth.

You recall that application was rejected by the Patent Office, and if you will continue on and look at page 34, you will see the rejection, and the rejection says:

"Claims 1-15 are rejected as being obvious over Druffel."

Now Druffel is the patent which was used in that Prescolite fixture which had the sensing device on the outside but had a hole in the inside so that the temperature came from the inside to sensing device.

Now if you will look at that patent, which is Defendant's Exhibit No. 118, if you look at 118 and look at Column 4 of 113 - - you will see the page that has Columns 3 and 4, if you look down about line 49, it says:

> "... a wireway for supporting to a compartment at least one wire and a temperature sensative device for interrupting electrical flow through the wire at a selected temperature within

the compartment."

That is inside the compartment. So what Mr. Druffel got a patent on was a device which sensed or measured the temperature or responded to the temperature inside the compartment. That is what the patent says.

Now, that patent the Patent Office held precluded the issue of the Kristofek patent which is the patent in suit in this case, and it rejected Claims 1 through 15 on the grounds that they were already covered by this patent which referred to a device which sensed the temperature within the compartment, inside the compartment.

So when that rejection was made apparent to the applicant, the applicant then came back and changed the application, and added the words back there on page 12, "the outside of" the fixture.

Go back to page 12, which you looked at earlier. I told you to ignore those words because they were not in the original application, but when the application was amended so as to meet the objections of the patent examiner that Druffel, the patent which measured the temperature or sensed the temperature within the container, already had a patent on sensing the temperature within the container, they then changed the patent to read, "adjacent to the outside of the fixture".

So the claim in the patent, if you will look at the patent itself, and when they went back to the Patent Office, in the file wrapper if you will look at the submission of the proposed amendment, they are very explicit that the reason why this is not covered by Druffel, is because this measures the temperature adjacent the outside of the fixture, whereas Druffel is a patent measuring the temperature inside, or sensing the temperature inside the fixture.

It was on that basis that they obtained the patent on a device which they said sensed or responded to the temperature outside, in the area outside the fixture.

Now if you look at the patent itself, which was granted, which is the very first exhibit in that book, No. 1, and you look at Claim 1, you will see that it says just what the amendment said it was going to say. If you look at line 46 of Column 6, it says:

> "45 a thermal protective device connected electrically to said lamp for discontinuing the operation thereof in response to the temperature in an area adjacent the outside of said fixture reaching a predetermined temperature".

Now that is what they got a patent on. They got a patent on a device which measured or sensed, or responded to - - the language is very clear here - - it says "in response to". In Claim 9 it says "sensed". If you look at Claim 9 the same language is used with respect to the outside, but it says:

> " . . . in response to the temperature in an area surrounding the outside of said lighting fixture reaching a predetermined temperature . . . "
>
> Says the same thing. Says response in both places.
>
> " . . . in response to the temperature in an area surrounding the outside of said lighting fixture reaching a predetermined temperature".

So what they have a patent on is a device which will cut out the electricity, will shut off the electricity at such time as the temperature outside the fixture reaches a predetermined level.

Now, what does the Juno TC2 device do?

Well, we had Professor Liljequist's description of it and the measurements. The thermal protected device is, as you know, mounted inside, as the patent specifies. But when you measure the temperature, whereas on the inside it is 102, 103, 101, on the outside it is only 91, actually right at the hole where it would, presumably, be the hottest where the temperature would be going out from the can into the

outside space, and therefore, would be the hottest, it would be 91.

Interestingly enough, it is also 91 just above the hole, where there is no hole at all, indicating that the hole doesn't make any difference. The temperature is the same at 91 degrees, whether there is a hole or there isn't a hole.

We know that these measurements were taken at the time the light went out, at the time that the thermal protection device worked, the time that it functioned. And we know that that thermal protection device was set at somewhere around 105 degrees, with plus or minus five degrees. So it could have gone off anywhere from 100 degrees to 110 degrees, but the temperature outside is only 91.

Now, the temperature inside is 103, or 102. Obviously, that device senses or responds only to the temperature inside because the temperature outside wasn't up to the critical point where the device would have functioned. At 91 degrees it would not have opened up. It would not have cut out. The light would not have gone out. Yet we know that these measurements were made at the moment the light went out, and we know that at that moment the temperature outside was 91 degrees, that the temperature inside was anywhere from 101 to 103 degrees.

So that the thermal protection device couldn't have been responding to the outside temperature because it would not respond to a temperature of less than 100 degrees, and yet the temperatures outside were all less than 100 degrees; whereas it would respond to a temperature anywhere over 100 to 110 degrees, and those temperatures inside were all over 100 degrees.

So it is clear that what this Juno TC2 device does is respond to the temperature not outside, but the temperature inside the can, in side the recessed fixture.

Now that is not covered by the Kristofek patent because the Kristofek patent very clearly says, temperature outside, not the temperature inside.

Under those circumstances there is no way that the patent can cover this device. It also, incidentally, doesn't cover the Halo device because I think the evidence is clear, including Mr. Schnoll's statement this morning that what the Halo device does is measure the temperature inside too. Both these devices, which are very similar in construction - - for all I know Juno copied Halo. Nothing wrong with copying a device if you don't infringe a patent. If the device is available for anybody to copy because it is in the public domain, as the law calls it, there isn't any infringement of a patent if the patent doesn't cover it.

I told you when I instructed you, don't compare the two devices. Compare the Juno device with the claims of the patent. The fact that the two devices may be identical doesn't mean that the Juno device infringes the Halo patent unless the Halo device is also covered by that patent.

But it is perfectly clear that the Halo device measures the temperature, or senses the temperature, or responds to the temperature inside because if you look at the temperatures there, here you have a sensor, thermal protection device which goes off at 95 degrees, and temperatures inside here are anywhere from 93 to 98, while outside they are 80, 86, 86, 87.

Interestingly, again, on the outside of the Halo, opposite the hole, the temperature is exactly the same as it is opposite the wall where there is no hole indicating that there isn't any difference in temperature, hole or no hole; that the hole doesn't contribute anything to the difference in temperature.

All of this, of course, rests on the fact that temperature goes from hot to cold. Hot air goes to cold air, not backwards. And these figures show that, as well as hav-

ing had that principle explained to us in the course of the testimony.

But the bottom line on all of this is that the claim of the patent, which has to be read strictly since it was amended so as to get the patent by narrowing it, or limiting it to the temperature outside the container, outside the fixture, doesn't cover a device which measures the temperature exclusively inside the fixture, as this indicates.

And so, in fact, it doesn't cover either the Juno TC2 or the Halo H-7, which means there is no infringement by Juno of this patent, which simply describes a device which does what this device does not do. This device measures inside temperature, or senses inside temperature, or responds to inside temperature.

I just looked up what response means. Response means to react. To react to what? React to inside temperature or react to outside temperature. The patent says the device reacts to outside temperature. All of the evidence indicates the device reacts to inside temperature.

Now, not only is the patent not infringed by the Juno TC2 device, because it doesn't sense or respond to outside temperature, it senses or responds only to inside temperature, it is not wilfully infringed. You can't wilfully infringe something you don't infringe so that takes care of the second question.

If you infringe you can wilfully infringe. If you don't infringe you can't wilfully infringe.

But we know from the evidence that that patent describes an impossible structure because that patent says if you put that thermal protection device inside the can, you can respond to the temperature outside the can.

We know from the testimony that we have had in the case, and nobody has testified that cold air comes from outside and goes in. All of the evidence is that hot air goes from inside out, and we also know that a thermal

protection device measures the temperature at the point where it is located. That is true whether you are talking about a thermostat turning on the furnace or turning off the furnace in your house. That depends on what the temperature is right where that thermostat is, and the temperature can be hotter or colder someplace else, but the thermostat doesn't go on until the temperature where the thermostat is, is at the critical point that you have set for it to go on or go off.

So we know that this thermal protection device functions only with respect to the temperature where the device is, and we know secondly, that cold air doesn't come in from the outside because as a matter of physical law the temperature the air will go from the hot air inside to the outside, not the other way around. Cold air doesn't come upstream against hot air, so to speak. And we know from these measurements that were made that the temperature outside is colder than the temperature inside, and that the temperature inside is within the critical range of the thermal protection device, and the temperature outside is outside that limit.

So what we are talking about is a patent which sets forth claims that cannot be achieved by the device or structure which it describes. You cannot sense or respond to the outside temperature with a device which mounts the thermal protection device inside, with a container which mount the thermal protection device inside.

The only thing that thermal protection device can sense or respond to is the temperature inside the can, and the patent very clearly says that it responds to the temperature outside the can. They wouldn't have gotten a patent over Druffel which said it measured or sensed, responded to temperature inside the can unless they inserted those words, "the outside of".

That is where the doctrine of file wrapper estoppel comes in. I explained it to you. If you can't get a patent

without changing your original claim and narrowing them or limiting them, then you are limited to the restricted or the new narrower claim. That is the doctrine of file wrapper estoppel.

You look at the patent and you read it, and you go back and look at how it got to where it is, and "the outside of" was inserted because Druffel said it measured the temperature inside, and the patent examiner said you can't get a patent unless you make it clear that it doesn't measure the temperature inside. So they wrote it and said it measured the temperature outside, only that isn't what it does.

So it is not a valid patent because it is a patent which describes a structure which won't work the way it describes it. That device with a thermal protection sensor inside, will not respond to the temperature outside the can. There is no way that it can.

Now, I don't blame you for being perplexed about all this because I suspect what happened is you concluded that Juno copied Halo, and if they did that there must be something to it.

I think there is. I think that Juno probably did copy Halo but they copied a device which is not covered by the patent which Halo owns, and the Halo device isn't covered by that patent, as I have indicated to you, because the Halo device cannot measure or respond to, or sense the temperature outside anymore than the Juno device can, given the structure and the nature of the physical laws that are applicable to it, and the actual measurements of temperature that we have with respect to the temperature is inside and out when the light goes out on these two devices.

So that I come to the conclusion, as I say, for only the second time in more than 25 years, that the evidence demonstrates that the conclusions which you reached are clearly erroneous; that they cannot be accurate, they cannot be true.

Therefore, I am going to set aside the findings which you made with respect to, 1, infringement, and necessarily, if there wasn't infringement there can't be wilfull infringement, and with respect to validity because the patent cannot be valid that describes an impossible or nonfunctioning mechanism. And, it is not infringed because it doesn't respond to the temperature outside the can. It clearly responds to the temperature inside the can.

I hope, and I don't want you to feel distressed about this. I have very strong feelings about asking lay people to listen to the kind of technical evidence that you get in a patent case, in addition to the patent mumbo jumbo like file wrapper estoppel and doctrine of equivalents, and prior art.

It is an area in which citizens are being asked to do close to the impossible. You know, the whole purpose of trial by jury is to take people of various experiences and let them look at and listen to the evidence about something that they may have some experience, not necessarily direct. You don't have to have direct experience with an automobile accident to evaluate what happened in an automobile accident. You don't have to have experience with negotiating corporate contracts to know whether or not there was an agreement that somebody would do something, and whether they broke that agreement, but when you are talking about whether or not the claims of a patent cover a particular structure or device, and whether or not the doctrine of file wrapper estoppel – it's not too complicated, I hope you understand it – if you change your application in order to get the patent, you are limited to the changes that you made, or by the changes that you make.

You heard Mr. Schnoll this morning say that the Halo device measures the temperature inside. Clearly does. All the evidence is that, and the Halo device and Juno device work exactly the same way. They both measure inside temperature.

How do we know it? We know it because when we put them to the test, they go off; and we know it also because hot air goes out, cold air doesn't come in.

I don't want you to feel bad. I don't blame you one bit for not having sorted all this out, but I think you didn't sort it out, and I think it is my responsibility, ultimately, under those circumstances, to reach the proper result, the just result under the law and the facts.

I think under the law and the facts in this case, it is clear that the patent was infringed by the Juno device. In fact, it doesn't even cover the Halo device. In fact, the patent is invalid because it describes a structure which won't work.

If any of you want to talk to me about this after you are through because this is an unusual situation, I will be happy to meet with you. It is only going to take me a minute to wind up what I have said, and I will be happy to discuss it with you further and answer any questions you have, make any other explanations that are necessary as well.

Mr. Stadheim would like to say something to you, and I certainly think he is entitled to, given the fact that I have now explained to you why I think his efforts, which were very good, I might say to you, he did a superb job with what I conceive to be a very difficult factual case.

MR. STADHEIM: You probably don't understand the law. I have tried to explain it to my wife, children, and other people, and it is difficult to understand.

What has just happened here, you have ruled, and I obviously think you ruled correctly. The Judge disagrees, and the Judge has ruled.

What will happen now, depending on what the various companies decide to do, it may very well be there will be an appeal. That will go to another court where there are no juries, no district court judges, and there will be more

briefs and oral argument, and if those judges agree with what we believe is the proper verdict that you came to, then they will reverse it.

If they do, the verdict that you brought in with regard to the $200,000 will be reinstated, and all your work will not have gone for naught. If they don't, well, so be it, and we will go on to another day.

We all have your names and addresses, and I will make sure that one way or another, you will hear what the final outcome of this case is.

Thank you.

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION

COOPER INDUSTRIES, INC.,
Plaintiff,
v.
JUNO LIGHTING, INC.,
Defendant.

85 C 7243

AMENDED SUMMARY OPINION*

This patent case was tried to a jury which found the patent in issue, U.S. Patent No. 4,450,512, infringed by defendant's TC2 recessed lighting fixture. It also found the infringement to be wilful and the patent to be valid. Our findings of fact include the stipulated uncontested facts and the findings we made orally in granting defendant's motion for a judgment notwithstanding the verdict (JNOV), all of which are adopted and incorporated by reference herein. Based on those findings and the conclusions of law stated orally at that time, we concluded that the jury verdicts on infringement, wilful infringement and validity were not only ones that reasonable persons could not have reached on the evidence but were clearly erroneous.

A. The Background

The stipulated facts and our previous oral findings fully delineate the background of and reasons for the development of recessed lighting fixtures containing a thermal protection device which will prevent the heat from the lamp causing a fire in any insulation which might be contiguous to the outside of the container or lamp housing (can) while at the same time not cycling on and off to the

---

*The amendments to the original opinion are underlined [italicized] herein.

irritation of the occupants (nuisance cycling). Accordingly, we will not repeat them here.

B. The Patent

After considerable experimentation, plaintiff's employee Paul J. Kristofek designed a unit in which a thermal protection device was mounted on the inside of the can adjacent to an opening or aperture in the can. The theory of the aperture as described in the patent was to permit the temperature sensitive element mounted inside the can "to accurately sense the temperature along the outer wall of the housing."

When the patent application was originally filed, the principle claim, Claim 1, in relevant part read "a thermal protective device connected electrically to said lamp for discontinuing the operation thereof in response to the temperature in an area adjacent to said fixture reaching a predetermined temperature . . . ." (Deft. Exh. 107, p. 12, Pat. Applic.) Claim 9, the other principle claim, originally read in pertinent part "thermal protective device for discontinuing the operation of said lamp in response to the temperature in an area surrounding the lighting fixture reaching a predetermined temperature . . . ." (Deft. Exh. 107, p. 14, Pat. Applic.)

The examiner rejected all 15 proposed claims in the application on the ground that under 35 U.S.C. § 103, they were unpatentable over U.S. Patent No. 4,358,635 issued November 9, 1982 to James B. Druffel and assigned to the Prescolite Co. another manufacturer of recessed lighting fixtures. Claim 1 of the patent specified that it involved "a temperature sensitive device for interrupting electrical flow through the wire at a selected temperature *within* the compartment." (Emphasis added). Interestingly, the device was mounted on the *side* of the can in the wireway and adjacent to an aperture in the can so that it could sense or respond to the temperature within the container.

In order to meet the examiner's objections and grounds for rejection, plaintiff's patent counsel made two changes in the proposed claims. In Claim 1 he inserted the words "the outside of" so that the revised claim read "in response to the temperature in an area adjacent to *the outside* of said fixture reaching a predetermined temperature . . .," and rewrote Claim 9 completely changing the pertinent portion to read "in response to the temperature in an area surrounding *the outside* of said lighting fixture reaching a predetermined temperature . . . ." (Emphasis added).

With the revisions in Claims 1 and 9, the patent issued on May 22, 1984.

C. The Issues

As previously indicated, three issues were presented to the jury on the question of liability (1) infringement, (2) wilful infringement and (3) validity or invalidity. On the first, the plaintiff had the burden of proof to establish infringement by a preponderance of the evidence. On the second, the plaintiff had a clear and convincing evidence burden as did the defendant on the contention of invalidity. The jury was so instructed. We will examine the evidence briefly as to each issue.

1. Infringement

The plaintiff called two witnesses, its employee and the inventor, Paul J. Kristofek, and the defendant's engineer, *Joseph* Stauner, who had designed the challenged Juno TC2 unit. Kristofek testified that he had conducted no tests to ascertain whether or not the thermal protection device in the challenged unit responded to the temperature in an area adjacent to the outside of the fixture. He acknowledged that he had made no tests as to whether even the structure on which he had obtained a patent, which was embodied in the Halo H-7 fixture, sensed or responded to the temperature outside the can. He stated that the device was "intended to respond to the tempera-

ture on the housing wall." On being pressed, he said "On the outside of the housing wall, but not, you know–how far out are you talking about?" He was then asked "How far away from the housing wall can you bimetallic element sense?" He answered, "I really don't know. It's never been tested that way." (Tr., p. 113).

With respect to how the thermal protection device mounted inside the can could sense or respond "to the temperature in an area adjacent to the outside of said fixture reaching a predetermined temperature . . . ," he conceded that at the critical point approximately halfway to the junction box the air would be "cooler outside the housing than inside" and that heat did not transfer "from outside that insulation area." (Tr., p. 155).

He stated that in the Halo device and presumably also in the Juno TC2 unit, although he had not tested it, the thermal protection device measured or responded to temperature both inside and outside the container. He asserted that the addition in the claims of the words "the outside of" was "an oversight on the part of our attorney when they drew it up." (Tr. pp. 161-162). At another point in his testimony, Mr. Kristofek was asked if he had not testified in his deposition that the thermal protectors in the Halo device responded "to temperature inside the housing; isn't that true?" He responded: "That's correct." (Tr., p. 174). While he believed it responded "primarily" to the outside temperature, "there is no way, unless we put in concrete, that you would not have some effect from the lamp." (Tr., p. 162).

Finally, he agreed that a light fixture in which the thermal protector responded to temperature inside the fixture would not infringe his patent. (Tr., p. 136).

Stauner, the defendant's engineer who designed the charged unit, was asked to explain how the thermal protector in the Juno TC2 functioned and responded that "it senses the temperature on the inside wall of the can where

it is mounted. It is really sensing the temperature right where it is at, and that is, when that temperature reaches a given point, namely approximately 105C, plus or minus five, it will cycle the fixture off." (Tr., pp. 251-252).

He testified that he had conducted tests of both the Juno and Halo units. The results of the Juno tests were recorded in defendant's Exhibit 183-A. The temperature readings were all taken at the moment the thermal protector tripped and interrupted the light circuit. The hottest temperature was, as might be expected, on the lamp side of the thermal protector Mylar cover inside the can and the coolest temperature was 1/8 inch outside the can in the insulation. The difference was between 105.1°C and 92.4°C. The thermal protector used was designed to trip at 105°C with a $+/-5°$ tolerance. The second hottest temperature was also inside the can at a point on the thermal protector adjacent to the wall between it and its Mylar sleeve cover where the temperature was 104.1°C. (Tr., pp. 257-259). Based on his experiments, Stauner concluded that the thermal protector in the Juno TC2 unit responded exclusively to the temperature inside of the can and did not respond to the temperature immediately outside of the wall since the thermal protector used would trip at 105°C but not at 92.4°C, the highest outside temperature. (Tr., pp. 259-260).

He also testified that while hot air flow into an area where the air is colder, cold air does not move into an area where there is hot air. Specifically, he said "Heat always flows out." (Tr., p. 260).

With respect to the Halo H-7 fixture, he conducted similar tests which are reported in defendant's Exhibit 183-B. Again, the measurements were taken at the time the unit cycled and the hottest point was on the thermal protector cover facing the lamp. The coolest point was outside in the insulation and was below the cut-out point of the thermal protector. Accordingly, he concluded that the Halo unit

which had a 90°C thermal protector with a +/−5° tolerance also responded to the temperature inside the can and not to the temperature in an area adjacent to the outside of the fixture.

While he did not testify during the trial on liability, the plaintiff's Vice-President in charge of sales, Edwin *Schnoll*, testified on the issue of damages. In discussing the various trims used on recessed fixtures, he pointed out that because different trims caused variations in the internal temperature of the container, the units had to be tested individually with each trim to determine whether or not they passed the Underwriter Laboratories (UL) standards. When asked whether the thermal protector devices responded to the temperature inside or outside the container, he said categorically "inside," otherwise it would not be necessary to test the units with the different trims.

The defendant called nine witnesses. Several described the development of the UL standards. None on either direct or cross-examination testified that the Juno TC2 unit infringed the '512 patent in suit. Nor, incidentally, had either of plaintiff's two witnesses.

Two of defendant's witnesses, its president, Robert S. Fremont, and an outside expert, Jon L. Liljequist, testified specifically with respect to the functioning of the charged device. Fremont, who at one time had been employed by the plaintiff and founded Juno in 1976 is well versed in the lighting industry, is active in the American Home Lighting Institute and was the spokesman for the group in the negotiations with UL relating to new standards for recessed fixtures involving thermal protection devices.

He stated flatly that such devices mounted inside the container sense or respond only to the temperature at the point where they are mounted.

Liljequist is a professor in the School of Architecture at the University of Illinois, Chicago, a lawyer and a patent consultant, one of whose clients is the Appleton Electric

Company in Chicago. Like Stauner, he conducted a series of tests with respect to the functioning of both the Juno TC2 and the Halo H7 recessed fixtures. The results and record of his tests are Court Exhibits 1 through 3E. While they were all exhibited to the jury during his testimony and used by him in the course thereof as well as considered by the jury during their deliberations, they were not formally offered in evidence by counsel. Since they are obviously relevant, we have made them part of the record as court exhibits.

Like Stauner, Liljequist measured the temperature at various points inside and outside the units at the moment the thermal protectors opened the circuits. The protector in the Juno unit was rated at 105°C +/-5°. Again the hottest temperature was on the lamp side of the protector and the temperature outside the container was the coolest. On the outside wall of the container the temperature was 10-11°C cooler than on the inside and well below the trip temperature of the thermal protector. Specifically, the inside temperature on the lamp side of the protector was 103°C outside the Mylar cover and 102°C inside the cover. On the other side of the protector towards the container wall the temperature was 101° and on the inside of the container wall was 93°. On the outside of the container wall opposite the 93° point, the temperature was 91°. Interestingly, it was also 91° on the aperture indicating that the aperture had no effect on the temperature. At a distance of 1/4" from the outside wall the temperature was 85°. All of the outside temperatures as well as the 93° temperature on the inside of the wall were below the thermal protector trip temperature. Professor Liljequist concluded from his tests that the internally mounted thermal protection device responded solely to the temperature inside the container and that the outside temperature had no effect on its functioning. Depending on the level of insulation placed around the container, he found that there was not a constant temperature differential between the inside and out-

side temperatures and that the differences between the inside and outside temperatures varied considerably but that the device tripped only when the temperature inside the container reached 101.5°C. At all times, however, the outside temperature was 5°, 6°, 8°or even 11°C cooler than that inside. As he put it, the thermal protector "really doesn't know what is going on outside." (Tr., pp. 751-754).

He reiterated Mr. Stauner's statements that hot air flows to cold air and not vice versa. He also testified that the patent described a device which could not physically function as claimed.

No witness testified that the thermal protection device in the defendant's challenged TC2 unit responded to or sensed the temperature in an area adjacent to the exterior surface of the housing as claimed in Claims 1 and 9 of the patent in suit. Given the history of the patent application and the insertion, in order to obtain a patent, of the specific reference to the area adjacent "to the outside" of the container, this is a classic example of the doctrine of file wrapper estoppel. The claims of the patent as issued are limited to a device in which the thermal protector senses or responds to the temperature in the area adjacent to the outside of the container. The evidence leads to only one possible conclusion. The plaintiff failed to establish by a preponderance of the evidence that the challenged device falls within or infringes the claims of the '512 patent.

2. Wilful Infringement

Since the TC2 unit does not infringe the patent in suit, there obviously was no wilful infringement.

3. Invalidity

The '512 patent is presumed, pursuant to the provisions of 35 U.S.C. § 282 to be valid and the defendant has the burden of proving invalidity by clear and convincing evidence. Because of the presumption of validity, the patentee need submit no evidence in support of a conclu-

sion of validity. When, as here, evidence is introduced challenging the validity of a patent, "a patentee would be well advised to introduce evidence sufficient to rebut that of the challenger." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc., et al.*, No. 85-2779 and No. 85-2812, slip op., pp. 8 and 9 (Fed. Cir. 1986). If the challenger's evidence is totally inadequate, however, the patentee need not introduce any rebuttal evidence and a patentee's motion for judgment or directed judgment should be granted.

In the instant case, at least three witnesses, Liljequist, Stauner and Fremont, testified that a thermal protection device mounted inside a container as specified in the '512 patent would not and could not sense or respond to the temperature in the area adjacent to the outside of the container. All three said specifically that the device responds to the temperature where it is located, inside the container. Stauner and Liljequist's tests established that the thermal protector functioned when the inside temperature reached the critical point even though the temperature of the outer wall of the container, much less the area adjacent to the outside of the container, was below the trip point. The temperature in the area adjacent to the outside was always cooler than the outer wall itself.

Stauner and Liljequist also testified that it is a basic law of physics that heat travels to cold and cold does not travel to heat, that given the heat source inside the container and the thermal sensor mounted inside the container, there is no way that the temperature outside the container can influence or trigger its operation. Finally, plaintiff's vice-president in charge of sales, *Schnoll*, testified that the sensor responds to the temperature inside the container.

Plaintiff offered no evidence to rebut this testimony. Even the inventor, Kristofek, acknowledged that the inside mounted sensor had to be influenced at least in part by the temperature inside the container *though* he believed

that it responded primarily to the outside temperature. He had, however, made no tests to confirm his belief. Nor did plaintiff present any other witness who had conducted any tests or had any basis for concluding that the device described in the '512 patent responded in any way to the temperature outside the container or could possibly do so.

Given the evidence presented by the defendant and the absence of any rebuttal evidence, the defendant clearly and convincingly established that the device described in the '512 patent does not and cannot function as claimed. Accordingly, the patent is invalid. *The court, in granting defendant's motion for JNOV on the issue of the invalidity of the '512 patent, did not consider that portion of defendant's motion concerning the invalidity of the '512 patent under 35 U.S.C. § 103.*

As indicated, I am convinced that upon the record before the jury, reasonable persons understanding the evidence could not have reached the three liability verdicts returned in this case. Accordingly, I am bound to set them aside. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1546 (Fed. Cir. 1983); *Quaker City Gear Works, Inc. v. Skil*, 747 F.2d 1446 (Fed. Cir. 1984), *cert. denied*, 105 S. Ct. 2676 (1985).

Readers of this opinion may wonder why, given the weight of the evidence as summarized herein, I permitted both the issues of liability and damages to go to the jury. In more than twenty-five years as a district judge, I have only once, and that in a criminal case, granted a motion for a directed verdict and withheld the case from jury consideration. Notwithstanding, this case is only the second in which I have set aside a jury's verdict and granted a JNOV. It is also my first patent jury trial although I have tried many complex jury cases, both civil and criminal, ranging from antitrust and securities violations to mail fraud and tax cases. In my judgment, juries are capable of handling the most difficult cases if counsel and the court effectively

organize the trial, the evidence, the instructions and the verdicts. This case is the exception. Having talked to the jury after setting aside their verdicts, I believe I understand what caused them to reach clearly erroneous conclusions, reasons which do not shake my faith in the ability of lay jurors to handle complex cases although patent cases may well be the most difficult for them to understand both as to the evidence and the law.

C. Conclusion

The jury found in separate verdicts that defendant Juno's TC2 model recessed lighting fixture infringed the plaintiff's '512 patent, that the infringement was wilful and the patent valid. It also awarded the plaintiff $200,000 in damages. For the reasons set forth herein, we granted the defendant's motion for a judgment notwithstanding the verdict as to the verdicts on infringement, wilful infringement and validity. As to the damage verdict of $200,000 on approximately $1,600,000 in sales, including sales of various trims necessarily used with the recessed fixtures, while the figure is generous, we believe, *if the patent is valid and was wilfully infringed,* it is within the range of the jury's discretion and will not set it aside.

An order consistent with the foregoing has previously been entered.

ENTERED:

/s/ HUBERT L. WILL
United States District Judge

DATED: January 28, 1987

UNITED STATES DISTRICT COURT OF APPEALS FOR THE FEDERAL CIRCUIT

COOPER INDUSTRIES, INC.,
Plaintiff-Appellant,

v.

JUNO LIGHTING, INC.,
Defendant/Cross-Appellant,

and

ROBERT FREMONT,
Defendant.

87-1146
87-1158

DECIDED: July 27, 1987

Before RICH, SMITH, and NIES, *Circuit Judges*.

RICH, *Circuit Judge*.

Note: This opinion has not been prepared for publication in a printed volume because it does not add significantly to the body of law and is not of widespread legal interest. It is a public record. It is not citable as precedent. The decision will appear in tables published periodically.

DECISION

Cooper Industries, Inc. (Cooper) appeals from the judgment notwithstanding the verdict (JNOV) of the United States District Court for the Northern District of Illinois, Eastern Division (Will, S.J.), holding that Juno Lighting, Inc. (Juno)* had not infringed any claim of Cooper's patent No. 4,450,512 ('512 patent) entitled "Arrangement

---

* Defendant Robert Fremont, President of Juno, was dismissed from the case and is not involved in this appeal.

for Mounting a Thermal Protective Device in a Recess Mounted Lighting Fixture" and that the patent is invalid. We *affirm*. Juno cross-appeals from the denial of its request for attorney fees which we also *affirm*.

OPINION

Infringement

To convince this court that the district court erred in granting Juno's motion for JNOV on infringement, Cooper must show that there was substantial evidence to support the jury's finding. *See, e.g., Fonar Corp.* v. *Johnson & Johnson*, 3 USPQ2d 1109, 1112 (Fed. Cir. 1987); *Orthokinetics, Inc.* v. *Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1571, 1 USPQ2d 1081, 1085 (Fed. Cir. 1986). Cooper mistakenly asserts that in deciding whether there was substantial evidence, "the focus is on the evidence that supports the verdict, not on the evidence that might support a contrary conclusion." Rather, as this court recently reiterated in *Fonar*, supra, " '[s]ubstantial evidence' is such relevant evidence from the record *taken as a whole* as might be accepted by a reasonable mind as adequate to support the finding under review." 3 USPQ2d at 1112 (quoting *Perkin Elmer Corp.* v. *Computervision Corp.*, 732 F.2d 888, 893, 221 USPQ 669, 673 (Fed. Cir.), *cert. denied*, 469 U.S. 857 (1984)) (emphasis added).

Applying this standard, we conclude, as did the district court, that no substantial evidence supports the jury's finding that Juno's TC2 fixture infringed claims 1-5 and 9-13 of the '512 patent. No witness, either for the plaintiff or the defendant, testified that the thermal protector in Juno's TC2 fixture sensed or responded to the temperature in the area adjacent to the outside of the container. The only evidence of infringement Cooper offered at trial was the testimony of the inventor, Paul Kristofek. He stated that he *assumed* that the Juno TC2 fixture responded to the outside temperature.

Juno, on the other hand, presented both testimony and test data which showed that the thermal protector in its fixture responded to the temperature *inside* the container. In fact, the evidence showed conclusively that the thermal protector could not sense or respond to the outside temperature if mounted inside.

Thus, we agree with the district court that, on this record, reasonable persons understanding the evidence could not have reached a verdict of infringement.

Invalidity

The district court held the '512 patent invalid on the ground that the device described in the patent specification "does not and cannot function as claimed." We agree.

Despite the inventor's theory of how his invention worked, the only evidence showed that a thermal protector mounted inside a container as specified in the '512 patent would not and could not sense or respond to the outside temperature. Therefore, the claims are invalid for either lack of utility under §101 or lack of enablement under §112, first paragraph. *See Raytheon Co.* v. *Roper Corp.*, 724 F.2d 951, 956, 220 USPQ 592, 596 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 835 (1984).

Other Issues

Since Cooper is not the prevailing party, we need not decide whether the district court erred in refusing to submit to the jury Cooper's claim that this was an exceptional case. Juno's claim that this was an exceptional case, however, remains.

Juno has accused Cooper of bringing and maintaining this suit in bad faith and of other misconduct during the trial. The district court, however, denied Juno's request for attorney fees under both 35 USC 285 and Rule 11, Fed R. Civ. P., in part because it felt that Juno's counsel mishandled the case.

While continuance of a suit in bad faith or other misconduct during trial may make a case exceptional under 35 USC 285, *see, e.g., Hughes* v. *Novi Am., Inc.*, 724 F.2d 122, 125, 220 USPQ 707, 710 (Fed. Cir. 1984), judgments of a district court concerning good and bad faith are not easily overturned, *Western Marine Elecs., Inc.* v. *Furuno Elec. Co.*, 764 F.2d 840, 847, 226 USPQ 334, 339 (Fed. Cir. 1985). Juno has not shown that there was substantial evidence which would have required the court to submit the case to the jury.

Juno apparently throws in Rule 11 for good measure, asking for sanctions against Cooper. This is obviously not a case for Rule 11 sanctions. As the district court pointed out, Cooper demonstrated that it could win before a jury. Although the district court ultimately granted judgment for Juno, it was apparently in spite of its counsel's performance, not because of it.

IN THE UNITED STATES DISTRICT COURT OF APPEALS FOR THE FEDERAL CIRCUIT

COOPER INDUSTRIES, INC.
Plaintiff-Appellant,

v.

JUNO LIGHTING, INC.,
Defendant-Cross/ Appellant,

and

ROBERT FREMONT,
Defendant.

87-1146, -1158

MOTION FOR PUBLICATION OF DECISION

Appellant, Cooper Industries, Inc., moves pursuant to this court's Rule 18 (c) that the decision in this case be published.

The decision was rendered on July 27 and designated not for publication. Appellant petitioned for rehearing and suggested rehearing *in banc*. On August 27, two orders issued: the first denying rehearing by the panel, and the second, requesting that appellee respond, by September 11, to the suggestion for rehearing *in banc*.

cc: Rolf Stadheim, Esq.
John P. Milnamow, Esq.

FILED
U.S. COURT OF APPEALS FOR
THE FEDERAL CIRCUIT
OCT 20 1987
FRANCIS X. GINDHART
CLERK

FILED
U.S. COURT OF APPEALS FOR
THE FEDERAL CIRCUIT
SEP 20 1987
FRANCIS X. GINDHART
CLERK

DENIED
FOR THE COURT,
GRANCIS X. GINDHART
10/19/87
CLERK

If this court's decision stands, it should not stand in the dark as an uncitable precedent, since it pronounces law that is contrary to that stated in *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1 USPQ2d 1081 (Fed. Cir. 1986).

The opinion here states (p.2):

> Cooper mistakenly asserts that in deciding whether there was substantial evidence, "the focus is on the evidence that supports the verdict, not on the evidence that might support a contrary conclusion."

Whereas, the opinion in *Orthokinetics*, F.2d at 1572, USPQ at 1085 holds:

> The district court focused on evidence in support of Safety's contentions, rather than on evidence in support of the jury's findings. That approach constitutes reversible error . . .

The Cooper assertion that was held to be "mistaken," was meant to be, and is, a paraphrase of the holding in *Orthokinetics*.

Respectfully submitted,

/s/ ROLF O. STADHEIM

ROLF O. STADHEIM
JOSEPH A. GREAR
HAIGHT & HOFELDT
55 East Monroe Street
Suite 3614
Chicago, Illinois 60603
(312) 263-2353
Attorneys for Plaintiff-Appellant

No. 87-1057

Supreme Court, U.S.
FILED
JAN 21 1988
JOSEPH F. SPANIOL, JR.
CLERK

In The Supreme Court of the United States

October Term, 1987

COOPER INDUSTRIES, INC.,

Petitioner,

vs.

JUNO LIGHTING, INC.,

Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

JOHN P. MILNAMOW
DRESSLER, GOLDSMITH, SHORE, SUTKER & MILNAMOW, LTD.
1800 Prudential Plaza
Chicago, Illinois 60601
(312) 527-4025
Attorneys for Respondent

Of Counsel:
EVAN M. KENT
DRESSLER, GOLDSMITH, SHORE, SUTKER & MILNAMOW, LTD.
1800 Prudential Plaza
Chicago, Illinois 60601
(312) 527-4025

January 22, 1988

Pandick Technologies, Inc., Chicago • (312) 236-0200

TABLE OF CONTENTS

Page (s)

TABLE OF AUTHORITIES ii

STATEMENT OF THE CASE 4

A. Petitioner Did Not Offer Any Evidence At Trial Of The Thermal Protector In Respondent's Fixture Or Any Fixture Made In Accordance With The Claims Sensing Or Responding To Outside Temperature So As To Support The Verdict As To Infringement Or Validity 4

B. The District Court's Opinion Granting Judgment Notwithstanding The Verdict 8

1. Infringement 8

2. Validity 9

C. Affirmance By The Court Of Appeals For The Federal Circuit 10

REASONS FOR DENYING THE PETITION 11

A. The Court Below Applied The Correct Standard Of Review 11

B. Petitioner Overstates The Conflict Between The Circuits 12

C. The Granting of JNOV Here Did Not Violate The Seventh Amendment 14

D. Under Any Standard Of Review JNOV Was Proper Here 15

E. Adopting Petitioner's Position Here Would Sanction An Absurd Result 16

CONCLUSION 19

TABLE OF AUTHORITIES

Cases: *Page(s)*

Anderson v. Liberty Lobby, Inc., 477 U.S. 242 (1986) 11, 12, 14

Boeing Co. v. Shipman, 411 F.2d 365 (5th Cir. 1969) 18

Brady v. Southern R. Co., 320 U.S. 476 (1943) 11

Connell v. Sears, Roebuck & Co., 722 F.2d 1542 (Fed. Cir. 1983) 10, 13

Coughran v. Bigelow, 164 U.S. 301 (1896) 12

Dace v. ACF Industries, Inc., 722 F.2d 374 (8th Cir. 1984) 13

DMI, Inc. v. Deere & Co., 802 F.2d 421 (Fed. Cir. 1986) 15

Fonar Corp. v. Johnson & Johnson, 821 F.2d 627 (Fed. Cir. 1987) 13, 17

Galloway v. United States, 319 U.S. 372 (1942) 14

Jamesbury Corp. v. Litton Indus. Products, Inc., 756 F.2d 1556 (Fed. Cir. 1985) 13

Moore v. Chesapeake & Ohio Railway Co., 340 U.S. 573 (1950) 18

Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565 (Fed. Cir. 1986) 12, 13, 17

Pennsylvania R. Co. v. Chamberlain, 288 U.S. 333 (1933) 12

Peters v. Active Manufacturing Co., 129 U.S. 530 (1889) 8

Page(s)

Pleasants v. Fant, 22 Wall 116 (1875) 12

Quaker City Gear Works, Inc. v. Skil Corp., 747 F.2d 1446 (Fed. Cir. 1984) 10, 13, 18

Verdegaal Brothers, Inc. v. Union Oil Co., 814 F.2d 628 (Fed. Cir. 1987) 13

Vieau v. Japax, 823 F.2d 1510 (Fed. Cir. 1987) 13

Wilkerson v. McCarthy, 336 U.S. 53 (1949) 18

U.S. Constitution

United States Constitution, Amendment VII 1, 14

Rules

Rule 50(b), Federal Rules of Civil Procedure 3

Statutes

35 U.S.C. 101 ..... 2, 3, 17

35 U.S.C. 112 ..... 2, 3, 17, 18

35 U.S.C. 282 16

Other

9 C. Wright & A. Miller, Federal Practice and Procedure §2529 (1971) 18

No. 87-1057

In The
Supreme Court of the United States
October Term, 1987

COOPER INDUSTRIES, INC.,

Petitioner,

vs.

JUNO LIGHTING, INC.,

Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

The Petition for a Writ of Certiorari here is based on supposed conflicts between the Judicial Circuits regarding the evidence to be considered in deciding a motion for judgment notwithstanding the verdict ("JNOV") and upon an alleged violation of the Seventh Amendment right to a jury trial when all relevant evidence is considered in overturning a jury verdict. The trial court granted JNOV holding the patent in suit not infringed and invalid.

Petitioner asserts that the proper rule as to which evidence should be considered in determining whether the verdict was supported by sufficient evidence is that only evidence in support of the verdict be considered, disregarding all other, on a motion for JNOV. Right or wrong,

however, even *under this rule, the granting of JNOV was* proper here.

The subject matter of the patent in suit concerns a lighting fixture having a thermal protective device located on the inside of the fixture sidewall which is to disconnect the fixture when a predetermined temperature is reached outside of the fixture. A thermal protective device or thermal protector is a device which contains a temperature-sensitive bimetallic element, which causes the electrical power to the fixture to cut out or shut off if the temperature on the bimetallic element reaches its rated temperature (0039).[1] In other words, the bimetallic element trips when its rated temperature is reached and opens the electrical circuit to the lamp in the fixture.

The claims of the patent in suit require that the thermal protector senses or responds to temperature outside of the fixture (0041). Thus, the single controlling fact issue as to infringement and validity in this case is whether the thermal protector in Juno's TC2 fixture senses or responds to outside temperature and whether lighting fixtures made in accordance with the claims of the patent in suit can sense or respond to outside temperature.

The District Court found that the Juno TC2 fixture did not and could not infringe any of the claims at issue as the thermal protector therein did not and cannot sense or respond to outside temperature (P.A. A21)[2] and that the claims were invalid under 35 U.S.C. §101 and/or §112 as the device described therein does not and cannot sense or respond to outside temperature as claimed (P.A. A23).

Notably, the Federal Circuit observed in affirming the judgment of Judge Will:

---

[1] The page references are to the Joint Appendix filed in the Court of Appeals for the Federal Circuit.

[2] Appendix to the Petition here.

"[W]e conclude, as did the district court, that no substantial evidence supports the jury's finding that Juno's TC2 fixture infringed claims 1-5 and 9-13 of the '512 patent. No witness, either for the plaintiff or the defendant, testified that the thermal protector in Juno's TC2 fixture sensed or responded to the temperature in the area adjacent to the outside of the container. The only evidence of infringement Cooper offered at trial was the testimony of the inventor, Paul Kristofek. He stated that he *assumed* that the Juno TC2 fixture responded to the outside temperature.

Juno, on the other hand, presented both testimony and test data which showed that the thermal protector in its fixture responded to the temperature *inside* the container. In fact, the evidence showed conclusively that the thermal protector could not sense or respond to the outside temperature if mounted inside.

Thus, we agree with the district court that, on this record, reasonable persons understanding the evidence could not have reached a verdict of infringement.

* * *

Despite the inventor's theory of how his invention worked, the only evidence showed that a thermal protector mounted inside a container as specified in the '512 patent would not and could not sense or respond to the outside temperature. Therefore, the claims are invalid for either lack of utility under §101 or lack of enablement under §112, first paragraph." (P.A. A26-27).

Thus, as the courts below recognized, no evidence was presented by Petitioner at trial that the thermal protector in the Juno TC2 fixture senses or responds to outside temperature or that such sensing or response was even possible in any fixture supposedly made in accordance with the claims of the patent in suit. Therefore, under any of the allegedly conflicting rules for determining a Rule 50(b) JNOV motion, JNOV was proper in this case, and the rule espoused by Petitioner cannot help Petitioner here.

Accordingly, Respondent Juno Lighting, Inc.[3] opposes the Petition for Writ of Certiorari requested in this case.

STATEMENT OF THE CASE

A. Petitioner Did Not Offer Any Evidence At Trial Of The Thermal Protector In Respondent's Fixture Or Any Fixture Made In Accordance With The Claims Sensing Or Responding To Outside Temperature So As To Support The Verdict As To Infringement Or Validity

The factual record in this case amply demonstrates that the granting of JNOV on both the issues of validity and infringement was proper under any and all of the supposedly conflicting rules for considering evidence on a JNOV motion as applied by the Judicial Circuits.

The claims of the patent in suit require that a thermal protector discontinue operation of a lighting fixture in response to the temperature in an area surrounding the outside of the lighting fixture reaching a predetermined temperature (0903-0904).

At trial, the only evidence that Petitioner offered regarding infringement by Respondent was the testimony of the inventor, Mr. Kristofek. He testified that he assumed that the Juno TC2 device responded to the temperature in an area surrounding the outside of the lighting fixture reaching a predetermined temperature (0169). Although Petitioner now claims that Mr. Kristofek testified that the TC2 fixture infringed, this is not supported by the record. Neither the District Court nor the Federal Circuit deemed the testimony relied upon by Petitioner to constitute any evidence of infringement. In fact, no test results or other evidence was offered by Petitioner to show that the thermal protector in the Juno TC2 fixture responds to temperature outside of the fixture as required

---

[3] Pursuant to Rule 28.1, Juno Lighting, Inc. states that it does not have any subsidiaries or affiliates.

by the claims. Indeed, Mr. Kristofek admitted that a fixture having a thermal protector that sensed or responded to inside temperature was not covered by nor would infringe the claims of the patent in suit (0230).

The evidence presented by Respondent at trial established that the thermal protector in the Juno (Respondent's) TC2 fixture responded only to inside temperature and, by Mr. Kristofek's own assessment, did not infringe. The evidence also clearly and convincingly established that the outside temperature could not be sensed by either Respondent's TC2 fixture or Petitioner's Halo H7T fixture.

In that regard, Mr. Stauner, a Juno engineer, testified regarding the results of tests he ran on the Juno TC2 and Halo H7T fixtures (1090-1094). The test results showed that, during operation of the fixtures, the temperatures outside of the fixture were always lower than the temperature inside of the fixture and, thus, temperatures outside the fixture never reached the rated cut-out temperature of the thermal protector in either fixture. Based upon these tests, Mr. Stauner testified that the thermal protector in the Juno TC2 fixture responded to temperature inside the fixture and not to temperature immediately outside the fixture side wall (0325-0328, 0333).

Mr. Fremont, President of Respondent, testified that the thermal protector in the Juno TC2 fixture cuts off the lamp in response to the temperature inside of the fixture (0510-0511), and does not respond to temperature outside the fixture (0513).

Professor Liljequist, Respondent's technical expert, testified regarding the results of tests he conducted with the Juno TC2 and Halo H7T fixtures by taking temperature readings at various locations inside and outside of the fixtures covered with insulation. The temperature readings were taken up to and including the time that the thermal protector tripped and turned off the lamps (0648, 0652-0657, 0672-0681).

Based on the results of these tests, (1150-1158, 1206-1207), Prof. Liljequist testified that in neither the Juno TC2 fixture nor the Halo H7T fixture does the thermal protector sense or respond to temperature outside the fixture housing (0651-0652).

Prof. Liljequist also testified that heat can only move in one direction, i.e., from hot to cold, and his observations established that, because this basic scientific principle governed the operation of the two fixtures, the cooler outside temperature could not get inside to the thermal protector to trip it. Prof. Liljequist's test results confirmed that cool air cannot flow to hotter areas, and that it would be impossible for the Juno TC2 or Halo H7T to sense or respond to temperature outside the fixture that is always cooler than the inside temperature (0682-0683, 0695-0699, 0705).

Therefore, Prof. Liljequist concluded not only that the Respondent's TC2 and Petitioner's H7T fixtures respond to inside temperatures, but that they cannot respond to outside temperature and, thus, the TC2 fixture could not infringe the claims at issue nor could any fixture supposedly made in accordance with the claims function as claimed (0682-0683, 0695-0705).

Prof. Liljequist's testimony was completely uncontroverted. Petitioner offered no evidence whatsoever to rebut this testimony. Even Mr. Kristofek was forced to admit that the thermal protector in the Halo (Petitioner's) H7T fixture responded, at least in part, to inside temperature, not just to outside temperature, as required by the claims (0213, 0255, 0427). Thus, it is clear that Petitioner presented no evidence at all of the single controlling fact issue in the case and, therefore, presented no evidence to support the jury verdict.

Petitioner argues that the listing by Underwriters Laboratories ("UL") of the Juno TC2 fixture constitutes sufficient evidence of infringement. At most, the listing comprises a circumstance of minimal probative value and

relevance; however, Petitioner's argument is misguided and an attempt to create evidence where none exists.

First of all, Petitioner has mischaracterized the UL test. The UL test does not require disengagement of the lamp in response to a predetermined outside temperature of 90°C. Indeed, the test simply does not require that the protector respond to or sense outside temperature at all.

Petitioner's argument is belied by its own documents introduced into evidence at trial. In a Cooper (Halo) brochure (1047-1052), the UL test requirements are described and it is stated that Halo (Cooper) has a fixture, the H7T, which satisfies the UL requirements (1049). The H7T fixture is then described as having a thermal protector that stops current to the lamp "when the temperature *in* the housing reaches a certain point" (emphasis added) (1051). Thus, the fact that the Juno TC2 fixture was listed by UL has nothing to do with the fixture responding to outside temperature as required by the claims of the patent in suit.

That Juno's TC2 fixture passed the UL test is not evidence of infringement nor does that fact weigh against the invalidity of the claims of the patent in suit. That is further demonstrated by the fact that a LITE BOX fixture of Prescolite, a third party, was the first lighting fixture to pass the UL test in question and be listed by UL (0445A). The Prescolite fixture is prior art to the alleged invention of the patent in suit (0053A) and is embodied in Druffel, U.S. Patent No. 4,358,635 (1019-1024). All of the originally filed claims in the application for the patent in suit were rejected over Druffel (0992). In response to the rejection, Petitioner admittedly narrowed the claims to recite that the thermal protector of the claimed fixture responds to temperature outside of the fixture (0041) in order to distinguish over Druffel (0996-0997), which was argued to have a thermal protector that sensed an inside temperature.

Thus, Petitioner did not consider the Prescolite fixture

to be an infringment of the claims of the patent in suit, as whatever infringes if later, anticipates if earlier. *Peters v. Active Manufacturing Co.*, 129 U.S. 530, 537 (1889). As the Prescolite fixture passed the UL test, by Petitioner's own admission, passing the UL test is obviously no evidence at all of infringement or the validity of the claims here at issue.

Clearly, whether evidence presented by Petitioner at trial is "sufficient" or not is actually a moot point as the alleged evidence presented by Petitioner was in fact, no evidence of infringement or validity as was recognized by both the District Court and the Court of Appeals. Indeed, under each of the supposedly conflicting approaches argued by Petitioner for deciding whether a jury verdict is supported by sufficient evidence, the District Court's granting of JNOV was mandated.

Simply put, Petitioner offered no evidence to prove that the thermal protector in the accused Juno TC2 fixture responded to temperature outside of the fixture, as required by the patent claims in order to find infringement. Moreover, Petitioner offered no evidence to prove that fixtures supposedly constructed in accordance with the patent in suit could operate by having the thermal protector respond to temperature outside of the fixture, as was necessary to rebut Respondent's contrary evidence, and to sustain validity of the patent claims at issue.

B. The District Court's Opinion Granting Judgment Notwithstanding The Verdict

1. Infringement

In its opinion granting JNOV, the District Court painstakingly went through the evidence (P.A. A14-23), not ignoring evidence presented by Petitioner or focusing on Respondent's contrary evidence, as Petitioner would have this Court believe, but searching for any evidence to support the jury's verdict.

With respect to the issue of infringement, the District Court found that Petitioner presented no evidence that Respondent's TC2 fixture sensed or responded to outside temperature as required by the claims at issue (P.A. A21):

> "No witness testified that the thermal protection device in the defendant's challenged TC2 unit responded to or sensed the temperature in an area adjacent to the exterior surface of the housing as claimed in Claims 1 and 9 of the patent in suit. Given the history of the patent application and the insertion, in order to obtain a patent, of the specific reference to the area adjacent "to the outside" of the container, this is a classic example of the doctrine of file wrapper estoppel. The claims of the patent as issued are limited to a device in which the thermal protector senses or responds to the temperature in the area adjacent to the outside of the container. The evidence leads to only one possible conclusion. The plaintiff failed to establish by a preponderance of the evidence that the challenged device falls within or infringes the claims of the '512 patent."

2. Validity

With respect to the issue of validity, the District Court also found that Petitioner presented no evidence that a fixture supposedly made in accordance with the claims could sense or respond to outside temperature (P.A. A22-23):

> "Stauner and Liljequist also testified that it is a basic law of physics that heat travels to cold and cold does not travel to heat, that given the heat source inside the container and the thermal sensor mounted inside the container, there is no way that the temperature outside the container can influence or trigger its operation. Finally, plaintiff's vice-president in charge of sales, *Schnoll*, testified that the sensor responds to the temperature inside the container.
>
> Plaintiff offered no evidence to rebut this testimony. Even the inventor, Kristofek, acknowl-

> edged that the inside mounted sensor had to be influenced at least in part by the temperature inside the container *though* he believed that it responded primarily to the outside temperature. He had, however, made no tests to confirm his belief. Nor did plaintiff present any other witness who had conducted any tests or had any basis for concluding that the device described in the '512 patent responded in any way to the temperature outside the container or could possibly do so.
>
> Given the evidence presented by the defendant and the absence of any rebuttal evidence, the defendant clearly and convincingly established that the device described in the '512 patent does not and cannot function as claimed. Accordingly, the patent is invalid."

The District Court further stated (P.A. A23):

> "As indicated, I am convinced that upon the record before the jury, reasonable persons understanding the evidence could not have reached the three liability verdicts returned in this case. Accordingly, I am bound to set them aside. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1546 (Fed. Cir. 1983); *Quaker City Gear Works, Inc. v. Skil*, 747 F.2d 1446 (Fed. Cir. 1984), *cert. denied*, 105 S. Ct. 2676 (1985)."

Thus, it is clear that the District Court expressly granted JNOV on the issues of validity and infringement on the basis of no evidence that the thermal protector in Respondent's TC2 fixture senses or responds to outside temperature or that a fixture supposedly made in accordance with the claims at issue could function as claimed.

C. Affirmance By The Court Of Appeals For The Federal Circuit

In affirming the District Court's granting of JNOV, the Court of Appeals for the Federal Circuit ("Federal Circuit") noted that Petitioner had to show that there was substantial evidence to support the jury's finding. The Court also noted that "substantial evidence" is such relevant evidence

from the record taken as a whole as might be accepted by a reasonable mind as adequate to support the finding under review (P.A. A26).

As to both of the issues of validity and infringement, as quoted above, the Federal Circuit agreed with the District Court that Petitioner presented no evidence of the single controlling fact issue so as to support the jury verdict (P.A. A26-27).

Indeed, the Federal Circuit thought that the case was so clearly properly decided by the District Court that it deemed its affirming opinion to not warrant publication as the opinion "does not add significantly to the body of law and is not of widespread legal interest." (P.A. A25).

Accordingly, the Federal Circuit denied Petitioner's Motion for Publication of Decision (P.A. A29). Without question, such a clearly correct decision as the granting of JNOV here is not the stuff of which a granting of a Petition for Certiorari is made.

REASONS FOR DENYING THE PETITION

A. The Courts Below Applied The Correct Standard of Review

This Court has noted " . . . the standard for a directed verdict under Federal Rule of Civil Procedure 50(a), which is that the trial judge must direct a verdict if, under the governing law, there can be but one reasonable conclusion as to the verdict. *Brady v. Southern R. Co.*, 320 US 476, 479-480, (1943)."[4] *Anderson v. Liberty Lobby, Inc.* 477 U.S. 242, 91 L.Ed2d 202, 213 (1986). "[R]ecent decisions of high authority have established a more reasonable rule, that in every case, before the evidence is left to the jury, there is a preliminary question for the judge, not whether there

---

[4] The Petitioner (n.4 at p. 6) correctly notes that the standard for a motion for JNOV is the same as for a directed verdict. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242 (1986).

is literally no evidence, but whether there is any upon which a jury could properly proceed to find a verdict for the party producing it, upon whom the onus of proof is imposed . . . See also *Pleasants v. Fant*, 22 Wall 116, 120-121 (1875); *Coughran v. Bigelow*, 164 U.S. 301, 307 (1896); *Pennsylvania R. Co. v. Chamberlain*, 288 U.S. 333, 343 (1933)." *Anderson, supra*, 477 U.S. at ___, 91 L.Ed2d at 213.

This was precisely the approach and standard both the District Court and Court of Appeals said was appropriate and which they followed. Each court looked for substantial evidence upon which a jury could reasonably find infringement and/or validity, and did not find it.

The case was properly decided and the Petition should be denied.

B. Petitioner Overstates The Conflict Between The Circuits

Petitioner makes much of supposed conflicts between the Circuits as to what evidence is considered in deciding whether a jury verdict is supported by sufficient or substantial evidence. However, Petitioner clearly overstates the extent of the conflicts, especially with respect to the Federal Circuit which heard the appeal in this case.

With respect to the Federal Circuit, Petitioner argued in its Petition for Rehearing and Suggestion for Rehearing In Banc, and continues to argue here, the baseless position that a conflict exists between various Federal Circuit decisions on JNOV Motions. Specifically, Petitioner relies upon a supposed conflict between the Federal Circuit's affirmance here and its decision in *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565 (Fed. Cir. 1986). However, the JNOV decisions of the Federal Circuit are totally consistent and no such conflict exists as the Federal Circuit itself recognized in denying and declining Petitioner's Petition for Rehearing and Suggestion for Rehearing In Banc, respectively.

Beginning with the seminal decision in *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542 (Fed. Cir. 1983), the Federal Circuit has, without deviation, applied the same standard in considering appeals from decisions regarding motions for directed verdict or JNOV. Please see *Vieau v. Japax, Inc.*, 823 F.2d 1510, 1515 (Fed. Cir. 1987); *Fonar Corp. v. Johnson & Johnson*, 821 F.2d 627 (Fed. Cir. 1987); *Verdegaal Brothers, Inc. v. Union Oil Co.*, 814 F.2d 628, 631 (Fed. Cir. 1987).

Petitioner's reading of *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565 (Fed. Cir. 1986) is distorted and erroneous and its reliance thereon misplaced. In that case, the Federal Circuit examined the evidence in the record and specifically found that there was indeed substantial evidence to support the jury's verdict. That finding was made after a careful analysis of all of the relevant evidence. Significantly, the Court stated "[t]his is not a case in which there was no evidence in support of a jury's finding, or one in which the only evidence relating to a finding was contrary to that finding." 806 F.2d at 1573. Of course, the situation in *Orthokinetics* is exactly the opposite of the situation here.

Petitioner further contends that the Federal Circuit's decision in *Quaker City Gear Works, Inc. v. Skil Corp.*, 747 F.2d 1446 (Fed. Cir. 1984) and *Jamesbury Corp. v. Litton Indus. Products, Inc.*, 756 F.2d 1556 (Fed. Cir. 1985) are at odds with *Orthokinetics*. It is not seen how any reasonable mind reading those decisions can come to that conclusion.

More importantly, the purported conflict between the various Circuits is totally irrelevant to this case. For example, Petitioner seems to rely heavily on the Eighth Circuit in *Dace v. ACF Industries, Inc.*, 722 F.2d 374, 376 (8th Cir. 1984) with the following quote therefrom:

> "... [W]e have said that the court is not to consider questions of credibility when deciding whether to grant a directed verdict.... That

> statement necessarily implies that evidence favorable to the moving party may not be considered, because if it were the court would have to pass on the credibility of that party's witnesses."

No one would deny that questions of credibility are absolutely within the exclusive province of the jury. But that is exactly not the case here, nor can Petitioner contend that it is. Here, Petitioner introduced no evidence which supported the jury verdict of validity and infringement and there are no questions of witness credibility.

C. The Granting Of JNOV Here Did Not Violate The Seventh Amendment

Petitioner argues that the granting of JNOV after a consideration of "all of the evidence" violates the Seventh Amendment right to trial by jury. However, it is abundantly evident that Petitioner's right to a jury trial was not violated here.

This Court has made it patently clear that the guarantee of a jury trial given by the Seventh Amendment does not deprive the Federal Courts of the power in a jury case to direct a verdict (or grant JNOV) upon the ground of the insufficiency of the evidence. *Galloway v. United States*, 319 U.S. 372, 389 (1942). In this case, Petitioner's evidence was, without question, insufficient to support the jury verdict.

If Petitioner's argument that a consideration of "all of the evidence" violates the right to a jury trial were carried to its logical conclusion, there could never be a JNOV (or a directed verdict) because the existence of any pretense or scintilla of evidence by the non-movant would be sufficient. Such an absurd concluson defies all logic and is contrary to all accepted judicial procedure. In a decision cited by Petitioner, this Court considered the standards applicable to a motion for summary judgment (and, by extension, to directed verdict and JNOV). In *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 91 L.Ed2d 202, 214, 216 (1986), the Court states:

> "In essence, though, the inquiry under each is the same: whether the evidence presents a sufficient disagreement to require submission to a jury *or whether it is so one-sided that one party must prevail as a matter of law.*
>
> * * *
>
> In sum, we conclude that the determination of whether a given factual dispute requires submission to a jury must be guided by the substantive evidentiary standards that apply to the case." (emphasis added)

To prevail on the issue of infringement, Petitioner was required to convince reasonable persons that infringement existed by a preponderance of the evidence. Implicit in such a standard is, of course, an examination and balancing of all of the evidence in the relevant record. The record is clear that Petitioner fell far short of discharging its burden of proof on that issue. Furthermore, Petitioner failed to rebut any of the clear and convincing evidence presented by Respondent at trial regarding the invalidity of the patent in suit. Petitioner's suggestion that the court must consider only the alleged evidence that supports the verdict is fallacious. It would appear that Petitioner is attempting to achieve what the Federal Circuit recently criticized when it stated "[a]n appeal is not a means for counsel to cure mistakes and omissions made at trial." *DMI, Inc. v. Deere & Co.*, 802 F.2d 421, 426 (Fed. Cir. 1986).

D. Under Any Standard Of Review JNOV Was Proper Here

This case is clearly not the proper case to resolve differences or conflicts, if any, in the standards of review on JNOV motions. Whether only Petitioner's alleged evidence, or all the evidence, is considered and evaluated, both the District Court and the Federal Circuit held there was no evidence in the record to support the jury verdict of either infringement or validity. Thus, Petitioner cannot prevail under any appropriate standard.

With respect to the issues of validity and infringement, Petitioner argues (p. 5) that the courts below ignored evidence supporting the verdict, focused on Respondent's contrary evidence, and concluded that there was no evidence in support of the verdict. Nothing could be further from the truth. The District Court carefully analyzed the relevant evidence relating to infringement (P.A. A16-21) and to validity (P.A. A21-23).

After analyzing all of the inventor's testimony relied upon by Petitioner, the District Court said (P.A. A17):

> "Finally, he agreed that a light fixture in which the thermal protector responded to temperature inside the fixture would not infringe his patent. (Tr., p. 136)."

Thus, in addition to all of the relevant evidence introduced by Respondent, the inventor himself finally admitted that there was no infringement. Clearly, the alleged evidence presented by Petitioner did not constitute any evidence of infringement or validity and the evidence presented by Respondent demonstrated that there could not possibly be any infringement and that the claims of the patent in suit called for an impossible result and were, therefore, invalid.

On appeal, the Federal Circuit again reviewed the record and affirmed the judgment of the District Court in all respects.

E. Adopting Petitioner's Position Here Would Sanction An Absurd Result

The absurdity of Petitioner's asserted position is best illustrated by considering the JNOV of invalidity. It is basic hornbook patent law that a U.S. Patent is presumed valid (35 U.S.C. §282). Theoretically, a plaintiff-patentee need only introduce his patent in evidence and the defendant then has the burden to prove invalidity by clear and convincing evidence overcoming the presumption. According to Petitioner's thesis, a JNOV could never be warranted or sustained because the court must focus

only on Petitioner's favorable evidence, namely, the bare patent itself. That is exactly what Petitioner is contending here because Petitioner introduced no evidence other than the patent to support a verdict of validity in the face of the clear and convincing proof of invalidity offered by Respondent.[5]

Reviewing the record with respect to validity, the District Court noted that at least three witnesses testified emphatically, and with supporting test data, that Petitioner's fixture (as well as Respondent's) could not function as claimed. The witnesses also testified about the basic laws of physics that applied. Because of this clear, convincing, and absolute evidence of invalidity, the District Court pointed out that "Plaintiff offered no evidence to rebut this testimony." (P.A. A22).

After reviewing the record on appeal, the Federal Circuit said:

> Despite the inventor's theory of how his invention worked, *the only evidence* showed that a thermal protector mounted inside a container as specified in the '512 patent would not and could not sense or respond to the outside temperature. Therefore, the claims are invalid for either lack of utility under §101 or lack of enablement under §112, first paragraph (emphasis added). (P.A. A27).

Quoting from *Orthokinetics*, 806 F.2d at 1570, the District Court pointed out (P.A. A22) that "[w]hen, as here, evidence is introduced challenging the validity of a patent, 'a patentee would be well advised to introduce evidence sufficient to rebut that of the challenger.'"

Once again, it is abundantly clear that Petitioner introduced absolutely no evidence, let alone substantial

---

[5] Interestingly, the Petition for Writ of Certiorari in *Fonar Corp. v. Johnson & Johnson*, No. 87-822, relied upon by Petitioner here only involves the issue of infringement, not validity.

or sufficient evidence, to rebut the clear and convincing proof of invalidity. It should also be noted that the question of enablement under 35 U.S.C. §112 is a question of law which may have underlying questions of law or fact. *Quaker City Gear Works, Inc. v. Skil Corp.*, 747 F.2d 1446, 1453 (Fed. Cir. 1984). Because Petitioner did not introduce any evidence to rebut the clear and convincing proof presented by Respondent, the District Court and the Federal Circuit properly held the patent invalid as a matter of law.

Petitioner places great emphasis upon *Wilkerson v. McCarthy*, 336 U.S. 53 (1949) which supports review of only evidence favoring the non-moving party on a motion for a directed verdict or JNOV. However, this is exactly what both courts below did in deciding this case. Whether *Wilkerson v. McCarthy* states a *sui generis* rule for federal employees' liability cases is a matter of some controversy. 9 C. Wright & A. Miller, Federal Practice and Procedure §2529 (1971) and please see *Boeing Co. v. Shipman*, 411 F.2d 365 (5th Cir. 1969). This is certainly not a FELA case. However, even in FELA cases, a directed verdict or JNOV, whatever standard of review of the evidence is used, is appropriate where there is "no evidence" supporting the non-moving party. *Moore v. Chesapeake & Ohio Railway Co.*, 340 U.S. 573, 578 (1950).

Without question, there is no standard of review which would help Petitioner here. Petitioner presented no evidence that Respondent's TC2 fixture senses or responds to outside temperature or that a fixture made in accordance with the claims at issue could sense or respond to outside temperature as required by the claims. Thus, Petitioner presented no evidence to support the jury verdict. Indeed, although Petitioner complains of the review of "all of the evidence" undertaken by both courts below, it was aided, not penalized, by the review of the entire record to search for sufficient evidence to support the jury verdict. However, even a search of the entire record could not

uncover any evidence, sufficient or otherwise, to support the verdict.

Accordingly, JNOV was appropriate in this case under any standard of review and, therefore, this is not the proper case to resolve the conflicts, if such exist, postulated by Petitioner.

CONCLUSION

For the reasons stated above, Respondent urges that the Petition for Writ of Certiorari be denied.

Respectfully submitted,

JOHN P. MILNAMOW
DRESSLER, GOLDSMITH, SHORE,
SUTKER & MILNAMOW, LTD.
1800 Prudential Plaza
Chicago, Illinois 60601
(312) 527-4025
Attorneys for Respondent

Of Counsel:
EVAN M. KENT
DRESSLER, GOLDSMITH, SHORE,
SUTKER & MILNAMOW, LTD.
1800 Prudential Plaza
Chicago, Illinois 60601
(312) 527-4025

January 22, 1988

No. 87-1057

Supreme Court, U.S.
FILED
JAN 29 1988
JOSEPH F. SPANIOL, JR.
CLERK

In The

Supreme Court of the United States

October Term, 1987

COOPER INDUSTRIES, INC.,

Petitioner,

vs.

JUNO LIGHTING, INC.,

Respondent.

PETITIONER'S REPLY MEMORANDUM

ROLF STADHEIM
HAIGHT & HOFELDT
224 S. Michigan Avenue
Suite 600
Chicago, Illinois 60604
(312) 939-7909

Counsel for Petitioner
COOPER INDUSTRIES, INC.

Of Counsel:
JOSEPH A. GREAR
DOUGLAS J. BORNEMANN
HAIGHT & HOFELDT
224 S. Michigan Avenue
Suite 600
Chicago, Illinois 60604
(312) 939-7909

ALAN THIELE
First City Tower
Suite 4000
Houston, Texas 77210

January 29, 1988

No. 87-1057

In The
Supreme Court of the United States
October Term, 1987

COOPER INDUSTRIES, INC.,

Petitioner,

vs.

JUNO LIGHTING, INC.,

Respondent.

PETITIONER'S REPLY MEMORANDUM

In opposing certiorari, Respondent does not quarrel with the Questions Presented, nor does it seriously challenge the conflict between the circuits, the Seventh Amendment issue, or the need for this Court's guidance in resolving those questions. Instead, Respondent concentrates on the facts of this case and particularly the evidence that it submitted - - evidence that is contrary to the jury's verdict and was presumptively rejected by the jury.

Five reasons are advanced for denying the Petition. As will be seen, none is sound.

A. STANDARD OF REVIEW
(pp. 11-12)

Respondent contends that the court below applied the proper standard of review regarding the sufficiency of the

evidence. But, that standard, which is well settled, is not in issue. As emphasized in the Petition (p. 8): "Thus, the question is not, *how much evidence* constitutes sufficient evidence to support a verdict, but *which evidence* is considered in deciding whether there is sufficient evidence."

As to the question presented, the court below held that it should consider the whole of the evidence; announced that it was "Applying this standard;" and did just that (A26). While consistent with the 5th, 11th and D.C. Circuits, that standard, or approach, conflicts with this Court's *Wilkerson* decision, as well as the various holdings of the 1st, 2nd, 3rd, 4th, 8th and Federal Circuits.

B. THE CONFLICT
(pp. 12-14)

The conflict is conceded by Respondent's silence. The heading for the second reason for denying the Petition asserts that the "... Conflict Between The Circuits" is overstated, but the text never addresses that claim. Rather, Respondent tries to reconcile the cases in but one circuit, the Federal Circuit, and then simply concludes with the *non-sequitur* (p. 13): "More importantly, the purported conflict between the various Circuits is totally irrelevant to this case."

C. THE SEVENTH AMENDMENT VIOLATION
(pp. 14-15)

No attempt is made to respond to the reasoning, set out in the Petition, that a court, in relying on "all of the evidence" in granting a JNOV, of necessity, "reexamines" the facts in violation of the Seventh Amendment. Instead, Respondent again confuses the non-issue of the amount or sufficiency of the evidence with the issue of which evidence is to be considered. Thus, its *reductio ad absurdum* argument ("carried to its logical conclusion ... any pretense or scintilla of evidence by the non-movant would be sufficient ... " (p. 14)) is inapposite to the issue raised.

D. & E. THE COURT BELOW IGNORED THE SUPPORTING EVIDENCE (pp. 15-19)

Reiterated throughout the Opposition is the assertion that there was no evidence supporting the jury verdict; that the lower court did not ignore any evidence; and, indeed, that it (p. 8) "painstakingly" searched the record for supporting evidence, but found none.

The plain fact is the courts below, in focusing on the contrary evidence, did not even mention, much less rely on, the U.L. tests. Those tests alone established that Juno's fixture disconnected, as recited in patent Claim 9, " . . . in response to the temperature in an area surrounding the outside of said lighting fixture reaching a predetermined temperature."

> Underwriters Laboratories . . . conducts tests as follows: . . . The thermal device must disconnect the fixture when any point in contact with insulation [outside the fixture] reached 90 degrees C. [0918]

Respondent's only attempted answer (p. 7) is its charge that Petitioner "mischaracterized" the U.L. tests - - a charge based solely on its own interpretation of an advertising piece of Petitioner. Weighing and interpreting the evidence was a function of the jury and it found, in accordance with the plain meaning of the exhibits, that the U.L. tests required that the lamp disconnect when the temperature outside the fixture reached a predetermined temperature. Thus, had the court below focused solely on the supporting evidence, rather than on all of the evidence, the verdict could not have been overturned.

CONCLUSION

The conflict between the circuits on the fundamental guarantee of the right to a trial by jury should be resolved by this Court. The writ should issue.

Respectfully Submitted,

ROLF STADHEIM
HAIGHT & HOFELDT
224 S. Michigan Avenue
Suite 600
Chicago, Illinois 60604
(312) 939-7909

Counsel for Petitioner
COOPER INDUSTRIES, INC.